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TRADE MARKS  
TRADE NAMES  
AND  
UNFAIR COMPETITION  
IN TRADE

MUNN & CO.  
NEW YORK



# TRADE MARKS, TRADE NAMES

AND

## UNFAIR COMPETITION IN TRADE

EDITED FOR  
THE BUSINESS MAN

BY

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## FOREWORD

The purpose of this little book is to present, in the simplest manner, consistent with comprehensiveness, an interpretation of the Federal statutes concerning trade-mark registration and protection.

As the book is intended for business men, we have avoided legal phraseology as much as possible as well as long quotations from court decisions, except where the inclusion of such excerpts was found necessary to a clear understanding of the subject.

Our large trade-mark practice, extending over many years, has developed the conviction in our minds that a great deal of useless labor in devising trade-marks that cannot be registered—to say nothing of vexatious litigation over defective marks—might be obviated by some such publication as this.

We call the attention of those who are interested in trade-marks to the superior facilities of our trade-mark department for handling business of this character.

Our service includes not only registration of trade-marks, and general trade-mark practice before the Patent Office, but also registration of trade-marks in foreign countries and the registration of foreign-owned marks in the United States.

Among our trade-mark clients are many of the largest and most successful business enterprises in America.

**MUNN & COMPANY**  
**NEW YORK AND WASHINGTON**

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### ABBREVIATIONS

F.....	Federal Reporter
N. Y. S.....	New York Supplement
App. D. C.....	Appeal Cases District of Columbia
A.....	Atlantic Reporter
N. W.....	North Western Reporter
N. E.....	North Eastern Reporter
U. S.....	United States Supreme Court Reports
App. Cases.....	Appeal Cases (English)
Sandf.....	Sandford's N. Y. Chancery Reports
N. Y.....	New York Court of Appeals Reports
W. N. Cases.....	Weekly Notes (English)
App. Div.....	Appellate Division (N. Y.)
P.....	Pennsylvania Reports
S. W.....	South Western Reporter

## CHAPTER I

### The Trade-Mark as a Business Asset

**I**F you should find in your Santa Claus stocking, next Christmas, a gift for the exclusive right to use the word "Royal" as a name for baking powder, you would be eight million dollars richer than you were the day before.

It is said, on good authority, that the Royal Baking Powder Company considers its trade-mark worth just \$1,600,000 a letter. This is, perhaps, the most valuable trade-mark in existence, though it is rivaled in value by "Kodak," "Unedea," "Ivory" (as applied to soap), "Coca-Cola," the name "Gillette" used in connection with safety razors, and a half dozen others. Each of these trade-marks has become a national institution. To displace them in the public mind would require competition of unheard-of magnitude and energy.

The name "Coca-Cola" is worth at least five million dollars; the Gorham silver-ware mark two millions, at a fair estimate; the trade-marks of the National Biscuit Company, all of which touch the highest standard of distinctiveness, must be the largest asset of that concern; and the name "Kodak"—where would the Eastman Company's business go to if it should hand over the trade-mark "Kodak" to some other concern, and go on making the same goods under the name of Smith's Hand Cameras?



A FIVE-MILLION DOLLAR TRADE-MARK.

When the American Tobacco Company was recently dissolved into separate companies, under the order of the Supreme Court, the trade-marks of the combination were estimated to have a value of \$45,000,000, out of total assets of \$227,000,000.

The aggregate total value of well-known American trade-marks must be in the hundreds of millions of dollars. But any estimate of the value of a trade-mark, apart from the business to which it applies, is necessarily a mere guess, for a trade-mark is a species of commercial property that cannot be sold by itself. It is inseparably attached to the business from which it emanates, and cannot be transferred without a transfer of the business. There are cases where a concern's trade-mark has become so valuable, through long years of popularity and profit-making, that it entirely overshadows all other assets of the business—in short, the business could not exist without it.

A trade-mark is a symbol of Good-Will—using the words "Good-Will" in the same sense that the bookkeeper uses them. It stands for built-up reputation; it is the link that connects the



ultimate consumer with the manufacturer. It preserves the identity of merchandise, and, in carrying out this function, it is a device of inestimable value to the commercial world.

Sometimes a complex chain of events is best explained by a simple illustration. With this idea in mind, let us put ourselves



THIS DRESSED-UP DUCKLING IS THE TRADE-MARK OF MERRIMACK DUCKLING FLEECE.

in the place of a woman who wants a cake of Ivory Soap. She lives in a desert town in Arizona. She cannot go half across the continent to Cincinnati to buy a five-cent cake of soap from Procter & Gamble. In fact, it is a safe bet that she never heard of Procter & Gamble, but she knows that she wants Ivory Soap. So she sends her little girl down to the "general" store, and this lisping messenger asks for "Ivory" Soap—not just plain "soap"—and brings the familiar package with the name on it back to her mother. If the storekeeper sends some other kind of soap the owner of the nickel knows instantly that she did not get what she wanted.

By means of the trade-mark "Ivory" the manufacturers in Cincinnati deal with this buyer in Arizona as surely and as expeditiously as if she lived across the street from their factory. Trace this transaction backward, and you will find its trail running unerringly through the retailer, the wholesaler, and the jobber to the manufacturer—and at every stage of its journey the product kept its personality. It left Cincinnati as Ivory Soap, and as Ivory Soap it was put into the consumer's hands.

Selling by trade-mark is one of the miracles of modern merchandising. Its development to a state of high efficiency has taken place during the last hundred years.

Competition is the basis of the modern industrial system. Plainly defined, a competitive system means a system under which every trader, large and small, must be prepared to justify his existence at any time.

In the early centuries of English industrial life, competition in the modern sense was unknown, as Townsend Warner points out in his "Landmarks of Industrial History." For centuries after the Norman conquest of England, all manufactured articles were produced by craftsmen—each master craftsman working in his tiny shop with two or three apprentices.

All craftsmen belonged to guilds, whose status and authority were recognized by the law of the time. These guilds fixed the prices of commodities—a price "fair to the seller and fair to the buyer." A craftsman could not push his trade beyond his own immediate locality, because in that event he would come in



conflict with his brother craftsmen. He made shoes, or harness, or wove rough woolen coats, and sold them to his neighbors at a price that was fair to him and fair to them, and in somnolent old age was gathered to his fathers, without having heard the word "competition" or its equivalent in burly Saxon-French.

With the decay of centuries, the gilds slowly passed away, and upon their ruins arose the modern factory system.

In the new adjustment of things, here and there a craftsman with more energy and a longer financial head than his fellows, began to extend his trade, and employ more journeymen and apprentices.

In 1550 John Winchcombe, "Jack of Newbury," a woolen weaver, had a hundred looms at work in his own house, and Winchcombe woolens were known as far as Antwerp. At the same time, London craftsmen were selling their goods all over England—or, at least, in the larger towns, and there was a growing trade with Flanders.

These manufacturers, as the circle of their trade expanded, began to see the desirability of marking their products in some way to identify them, so that purchasers at a distance would be able to distinguish them from similar articles produced by others.

Any device for identifying a commercial product is a trade-mark, in the broad significance of the term.

Some of the early trade-marks were rude initials and cryptic designs of interlaced crosses and circles. Others consisted of dragons and winged snakes, and various real and unreal animals.

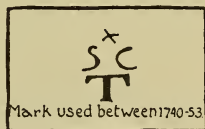
The craftsmen of the fifteenth and sixteenth centuries were the first users of trade-marks in England.

The flickering torch of the antiquarian throws a dim light on some sort of trade-mark usage current among the Greeks and Romans, and even among more ancient trading peoples, but these researches hold but little of interest to us. Our present purpose is to consider the function of the trade-mark in modern business, and with that thought in mind, it may be taken as an established fact that trade-marks, in the modern sense, have a continuous history of perhaps five hundred years.

In the early part of the seventeenth century the gold-beaters of Nuremberg were using trade-marks, and they had systematized their use to such an extent that an official register of gold-beaters' marks was kept and penalties for the misuse or counterfeiting of trade-marks had been established a law. This register has been preserved. Its yellowed pages are decorated with curious devices of serpents and dragons, doves and crosses. Without exception, the marks of the Nuremberg gold-beaters were picture marks.

**SAPOLIO**

A WORLD-FAMOUS TRADE-MARK. THIS IS A COINED WORD, DEvised ABOUT THIRTY-FIVE YEARS AGO BY DR. CAMERON, A PHYSICIAN.



Mark used between 1740-53



DERBY PORCELAIN TRADE-MARKS  
ORIGINATING AROUND THE MIDDLE  
OF THE EIGHTEENTH CENTURY.

In the early part of the eighteenth century the use of trade-marks was general, in certain lines of trade, throughout Europe. But the lack of specific legislation for the registration of trade-marks at that time—a lack that persisted until the nineteenth century—leads one to the conclusion that these eighteenth century traders did not attach great importance to the subject. They evidently considered the trade-mark a mere minor accessory of business.

The early decades of the nineteenth century witnessed the rise of three great forces which were destined to accomplish, in a short time, the most profound changes in manufacturing and selling methods. These forces were:

- 1st. The application of steam power to manufacturing in a large and economical way.
- 2nd. The development of cheap and quick transportation.
- 3rd. The invention of means for the rapid dissemination of intelligence.

Factories, employing thousands of hands—great industrial monuments to Cheap Power—had inevitably to find distant markets for their products. No longer could the manufacturer sit at home and await the buyer. His product was too large, and its burden was too heavy to carry on a haphazard sales plan. Consequently, the selling departments of all enterprises grew tremendously in importance. Customers were sought across the breadth of a continent. Many a manufacturer's sales area grew, in the span of a generation, from a few hundred square miles to a region that included every degree of climate from the Arctic to the Torrid.

To accomplish this result efficient selling methods, and economical and fast transportation, were required.

As a natural consequence of these conditions trade-marks grew in importance. Manufacturers without trade-marks found

## **“WISHBONE”**

Registered Trade Mark

TRADE-MARK FOR COAT HANGERS  
SHAPED SOMEWHAT LIKE A WISH-BONE.

that they had no hold on their trade. The consuming public did not know them or their products by name, and they were at the mercy of the jobber, the wholesaler and the retailer. They were sup-

ported by a chain of circumstances, of which every link was weak.

On the other hand, manufacturers whose trade-marks were firmly fixed in the public mind by reputation began to see that

they were, to a large degree, independent of the merchandising chain. The ultimate consumer knew their trade-marked products, and asked for them by name.

Thus, by a process of natural evolution, the trade-mark developed in importance from a workman's tool mark to a symbol of Good-Will—a business asset in a tangible form.

It is an axiom of legal philosophy that when a thing becomes valuable or desirable, legislation concerning its regulation and protection springs into being. Consequently one looks for, and finds, the beginning of specific legislation on the subject of trade-marks around the end of the first quarter of the nineteenth century.

Before the first trade-mark legislation, cases of infringement fell under the common law, and were decided in courts of equity.

H. D. Nims, a well-informed writer on trade-marks, says in his "Law of Trade-Marks and Unfair Trade":



(Trademark Reg. U. S. Pat. Off.)

THIS TRADE-MARK OF A  
DUSTLESS MOP IS AN EX-  
CELLENT EXAMPLE OF LETTERS  
USED AS A MARK.

"It is rarely that one life sees the genesis and maturity of law, yet it has almost seen them of trade-mark law. In the eighteenth century there were a few scattered decisions which turned almost wholly on the question of fraud. With the rise and growth of machine-made merchandise in the earlier part of the last century, the matter of private marks of merchants to distinguish wares going out into the public markets of the world assumed importance and cases multiplied. Trade-mark law is one of the results of machinery. It is safe to say that the great mass of trade-mark and unfair-trade law is the development of the last forty years."

A structure, of which the foundation has been so recently laid, must necessarily be still unsettled. The rulings of both the Patent Office and the courts are, in many cases, contrary to precedent. In some instances, courts in different parts of the country have handed down contradictory decisions bearing on the same question. But, despite these drawbacks, a body of trade-mark law is being slowly formed, and it is only a question of time before our feet will be on firm ground.

Trade-mark cases should be entrusted to attorneys who have specialized in this branch of the law. The legal status of this subject is changing so swiftly that an ordinary lawyer, absorbed in general practice, cannot keep track of it.

A trade-mark has been defined as follows:

"A trade-mark may be tersely defined to be any sign, mark, symbol, word or words which indicate the origin or ownership of an article as distinguished from its quality, and which others have not the equal right to employ for the same purpose. In its strictest sense, it is applicable only to a vendible article of merchandise to which it is affixed."

(*Ball v. Broadway Bazaar, Court of Appeals, N. Y., 87 N. E. 674.*)

We give this definition because it expresses in the fewest possible number of words the function and limitations of trade-

marks. Also, because there is in the minds of many business men, a confused notion of the difference between a trade-mark and a trade-name. By referring to the definition it will be noted that a trade-mark is "applicable *only to a vendible article of merchandise to which it is affixed.*"

On the other hand, a trade-name applies to a business as a whole, although this business may be engaged in the sale of not one vendible article only, but a thousand. For instance, "Wanamaker's" is a trade-name and "Kodak" is a trade-mark.

A trade-mark has no value except that created by the quality, sale, popularity and profit in the article to which it is affixed. No matter how distinctive, or attractive a mark may be, it is worth but little if it is used in connection with an inferior article or with an article sold without profit.



A VERY SUGGESTIVE  
AND SUCCESSFUL  
TRADE-MARK.

But a distinctive and suggestive trade-mark is of immense help in advertising and selling. Consider, for example, the trade-mark of Old Dutch Cleanser. It is full of *human interest, motion, life, and suggestion.* It brings up in the mind the mental picture of dirt fleeing from an energetic Dutch scouring woman. That this mark has been a powerful aid to sales is obvious. Suppose Old Dutch Cleanser had been called Climax Cleaning Powder. Can you imagine anybody acquiring more than the most languid interest in anything with a name so dull? It reminds one of hard and sordid toil.

## CHAPTER II

### The Federal Trade-Mark Law

**T**HE function of a trade-mark is to denote origin. As we pointed out in the preceding chapter, the necessity for using trade-marks arose as soon as the expanding wave of trade carried a craftsman's goods to customers outside of his own community. The ancient trade-mark was a simple device invented for the purpose of enabling a maker of any commodity to hold his out-of-town customers, so to speak, by enabling them quickly and surely to identify his goods.

Throughout its history the trade-mark has remained true to its ancient antecedents, and its purpose to-day, as it was in the fifteenth century, is specifically to indicate the origin of an article of merchandise.

In this aspect of unchanging purpose, the trade-mark is somewhat an anomaly in commercial history. During the last four hundred years, methods of manufacture, distribution and sale have been revolutionized from top to bottom: banks, which began as mere money-changing offices, have become establishments for keeping and loaning funds; the retailer, who used to sit in a hole in the wall with a handful of goods, all of the same kind, has developed into a merchant selling ten thousand different articles; the craftsman, who once served a long apprenticeship, during which he learned to make every part of a shoe or a carriage, has become a specialized laborer, employed by the day to produce the extreme subdivision of a finished article.

It is strange that, in all this evolution of commercial methods, the trade-mark did not undergo a change in function. It might have become, by a gradual transformation, a merchant's mark, applied indiscriminately to all goods of every description sold by him. Or, it might have evolved into a stamp of merit or high quality, regulated by statute and licensed only to manufacturers who could prove their right to use it.

But none of these changes has taken place, and the trade-mark of the twentieth century has for the beginning and end of its function the purpose of indicating to buyers the association of merchandise with a particular manufacturer or dealer.

The present Federal Trade-Mark law went into effect on April 1, 1905.

The reader should understand clearly that the right to own a trade-mark is not a creation of the statute, for the use of trade-marks, and the recognized right of manufacturers to be protected in their use, far antedate any specific trade-mark legislation.



The intent of the statute is to systematize and codify trade-mark practice. It provides a definite procedure for the registration of trade-marks; lays down rules for validity in marks; puts trade-mark litigation, when registered trade-marks are the subject matter of the litigation, within the jurisdiction of the Federal Courts; and makes every trade-mark registered under the law a part of the public records of the nation. But a trade-mark may be legally sound even if not registered, just as a person may own real estate without recording the title.

The Act of  
1905



THE POM-  
PEIAN WINDOW  
SCREEN TRADE-  
MARK.

The ownership of trade-marks, like any other property right, is recognized by the common law. The Supreme Court of the United States has said: "The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity with compensation for past infringements."

Trade-marks, under the Act of 1905, are registered in the United States Patent Office.

In case of litigation resulting over the right to use any trade-mark, evidence of the registration of the mark by one of the litigants puts the burden of proof upon the other. In other words, the user of the unregistered trade-mark must prove priority of use and ownership. This is often a very difficult thing to do, especially in the case of trade-marks that have been used a long time, for such proof must necessarily rest upon the production of old labels, packages of the goods with the trade-mark affixed, and the testimony of witnesses.

The owner of a registered trade-mark does not need any evidence other than the public records of the Patent Office to establish the date of his first use of the mark.

When a trade-mark is not registered in the Patent Office, litigation concerning it does not come under the jurisdiction of the Federal courts, unless the opposing parties are citizens of different states.

On the other hand, all cases pertaining to registered trade-marks used in interstate or foreign commerce fall within the field of Federal jurisdiction, irrespective of the amount in dispute or the place of residence of the parties. This is an advantage, owing to the fact that an injunction secured in one Federal Court will be enforced in all such courts in any state.

The fee charged by the Patent Office, under the law, for registering a trade-mark is ten dollars. This does not include the attorney's fee, which must be paid by the applicant.

A certificate of registration remains in force for twenty years, and it may be renewed, upon expiration, for like periods of twenty years, upon payment of a renewal fee of ten dollars.

An individual or corporation has a right to register a trade-mark under the United States law if the trade-mark for which registration is sought belongs to the applicant and is used by him:

- 1st. In commerce among the several states:
- 2nd. Or, in commerce with foreign nations;
- 3rd. Or, in commerce with the Indian tribes:

provided the owner of the trade-mark resides within the territory of the United States (which includes all territory under United States control), or has a business establishment situated in United States territory, or resides in any foreign country which affords, by treaty, similar privileges to citizens of the United States.

Divested of legal verbiage, the main provisions of the Act, so far as the features governing registration are concerned, may be stated as follows:

**A trade-mark** A design or wording identical with a registered or known is **not regis-** trade-mark owned and in use by another, and appropriated **trable if it is:** to merchandise of the same descriptive qualities, or which so nearly resembles a registered or known trade-mark owned and used by another, and appropriated to merchandise of the same descriptive qualities, as to deceive purchasers, or to be likely to cause confusion in the mind of the public.

The insignia of the American National Red Cross Society.

The flag or coat of arms of any foreign nation.

Any design or picture which has been adopted by a fraternal society as its emblem.

A portrait of a living individual unless the application for registration is accompanied by the written consent of the individual whose portrait is used.

Scandalous or immoral matter of any description.

The flag, or coat of arms, of the United States, or of any state, or of any municipality, or any of the insignia thereof.

Any geographical name or term.

A misrepresentation of the quality, composition, character, origin, or nature of the commodity with which it is used.

Any mark which consists merely in the name of an individual firm, corporation, or association, unless said name is written, printed, impressed or woven in some particular or distinctive manner, or is used in connection with a portrait of the individual.



A CELEBRATED UNDERWEAR TRADE-MARK, COMPOSED OF THE WORDS "POROUS" AND "KNIT." THIS MARK SEEMS ALMOST DESCRIPTIVE, BUT IT DOES NOT "DESCRIBE THE GOODS." IT DESCRIBES THE KNITTING PROCESS ONLY.



Any arrangement of words or devices descriptive of the goods with which they are used, or of the character or quality of such goods. In other words, a trade-mark must not be an advertisement in the ordinary sense of the word.

**A trade-mark is registrable if it is:** Unlike any other trade-mark, already in use, and applied to the same class of goods. It must not resemble the trade-mark of a competitor, or of a potential competitor, to such an extent that the buying public is likely to be deceived or confused by the resemblance.

The business name of a person or firm when written, printed, impressed or woven in some distinctive manner, or in association with a portrait, or in an autographic form.

Any trade-mark which has been in continuous and exclusive use by the applicant since February 21, 1895.

An arbitrary symbol, or word, or words, or a combination of a device and wording, not obviously descriptive of the commodity to which it is to be applied.

Used in lawful trade.

Of such a character that it may be affixed, printed upon, woven, sewed, branded or otherwise impressed upon the product with which it is used, or upon the package or container of the product.

The right to register trade-marks is limited to individuals and corporations.

Under the United States law an association cannot possess a trade-mark, as *exclusive ownership* and *specific origin* are essential attributes of validity.

The letters "A-A. L," meaning Anti-Adulteration League, were refused registration as a trade-mark for flour on the ground that the mark did not represent origin, but membership in an association. The applicant was a voluntary association of flour manufacturers. It was held that an association cannot be the "owner" of a trade-mark within the meaning of the statute.

Some states have enacted laws prohibiting the unauthorized use of the labels of trade-unions and similar associations. These laws are not trade-mark statutes. They are based on the broader principle of unfair business competition.

It is the general opinion, we believe, of trade-mark authorities that the lack of provision in our law for association trade-marks is a defect that should be remedied as soon as possible. It is a noteworthy fact that most of the other great nations recognize association marks.

An interesting example of an association trade-mark is that of the Irish Industrial Development Association (reproduced on this page). This association has a membership of about five hundred Irish manufacturers. Its use indicates that the merchandise to which it is affixed is of Irish manufacture; in other words,



THE IRISH NATIONAL  
TRADE-MARK.

it is indicative of geographical origin. The Irish trade-mark

has been registered in Great Britain under the British Trade-Mark Act of 1905.

An American by the name of D. B. Barrett attempted to register this mark in the United States Patent Office under his own name. This fact came to the attention of the Irish Industrial Development Association, and some correspondence relating to the matter passed between Mr. John Redmond, the leader of the Irish National party in Parliament, and President Taft. As the law now stands this Irish trade-mark cannot obtain in the United States the protection that registration might give.

Within the last few years several American communities have adopted trade-marks, or labels. The Omaha trade-mark is reproduced here as an example of this class of marks.



THE OMAHA TRADE-MARK, WHICH WAS CHOSEN FROM 764 DESIGNS SUBMITTED. THE DESIGNER RECEIVED A PRIZE OF \$500. THIS MARK WILL BE REPRODUCED ON ALL STATIONERY OF OMAHA MANUFACTURERS AND WILL BE AFFIXED TO ALL OMAHA-MADE GOODS.

There is a genuine need for an amendment to the law that would give this class of marks the right of registration.

A provision of the Act of 1905 legalized all trade-marks that had been in exclusive use by the applicant for ten years prior to the passage of the act, and this provision applies even to trade-marks of ten years' standing that, because of their character, could not be registered under the act. The wording of the act dealing with this subject is as follows:

"Nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the trade-mark is derived, in commerce with foreign nations or among the several states, or with the Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act."

A manufacturer cannot register a trade-mark and file it away with the intention of using it at some future time. A condition of validity is that the mark must not only belong to the applicant, but must be "used by him in lawful trade." An intention to use a mark is not sufficient. The use in interstate trade must antedate the application for registration. The letter of the law is complied with if a single package of the goods with the trade-mark affixed is sold in good faith in interstate or foreign commerce, although the shipment of a sample is not sufficient.

Those who intend to adopt trade-marks should keep in mind that the use of a trade-mark is limited strictly to one class of merchandise, which must be the class for which it has been registered.

#### The Ten Years' Clause

#### Classification of Merchandise

The  
**Coward**  
**Shoe**

"REG. U. S. PAT. OFF."  
A TRADE-MARK REGISTERED UNDER THE TEN YEARS' CLAUSE.

For purposes of classification the Patent Office has separated all merchandise into forty-nine general classes, as follows:

- |  |   |
|--|---|
| 1. Raw or partly prepared materials.                       | 25. Locks and safes.  |
| 2. Receptacles.  | 26. Measuring and scientific appliances.  |
| 3. Baggage, horse equipments, portfolios, and pocketbooks. | 27. Horological instruments.  |
| 4. Abrasive, detergent, and polishing materials.           | 28. Jewelry and precious-metal ware.  |
| 5. Adhesives.  | 29. Brooms, brushes, and dusters.   |
| 6. Chemicals, medicines and pharmaceutical preparations.   | 30. Crockery, earthenware, and porcelain.   |
| 7. Cordage.  | 31. Filters and refrigerators.  |
| 8. Smokers' articles, not including tobacco products.      | 32. Furniture and upholstery.   |
| 9. Explosives, firearms, equipments, and projectiles.      | 33. Glassware.  |
| 10. Fertilizers.   | 34. Heating, lighting, and ventilating apparatus, not including electrical apparatus. |
| 11. Inks and inking materials.                             | 35. Belting, hose, machinery packing, and non-metallic tires.                         |
| 12. Construction materials.                                | 36. Musical instruments and supplies.   |
| 13. Hardware and plumbing and steam-fitting supplies.      | 37. Paper and stationery.   |
| 14. Metals and metal castings and forgings.                | 38. Prints and publications.  |
| 15. Oils and greases.                                      | 39. Clothing.   |
| 16. Paints and painters' materials.                        | 40. Fancy goods, furnishings, and notions.  |
| 17. Tobacco products.                                      | 41. Canes, parasols, and umbrellas.   |
| 18. Vehicles, not including engines.                       | 42. Knitted, netted, and textile fabrics.   |
| 19. Linoleum and oiled cloth.                              | 43. Thread and yarn.  |
| 20. Electrical apparatus, machines, and supplies.          | 44. Dental, medical, and surgical appliances.   |
| 21. Games, toys, and sporting goods.                       | 45. Beverages, non-alcoholic.   |
| 22. Cutlery, machinery, and tools, and parts thereof.      | 46. Foods and ingredients of foods.   |
| 23. Laundry appliances and machines.                       | 47. Wines.  |
|  | 48. Malt extracts and liquors.  |
|  | 49. Distilled alcoholic liquors.  |
|  | 50. Merchandise not otherwise classified.   |

(Note: Class 18 was abolished Feb. 24, 1909.)

An applicant for registration must specify not only the general class of merchandise in connection with which he intends to use his trade-mark, but must state also specifically the articles in that class upon which he has used the trade-mark he seeks to register.

For instance, a manufacturer who might apply for the registration of "Pendennis," as a trade-mark for smoking tobacco—to select a word at random—would find that it would not be satisfactory to the Patent Office to state in his application that the mark was being used in connection with Class 17—"Tobacco products." He would be required to state that his mark was being used on "smoking tobacco." After registration had been granted the Patent Office would not register another "Pendennis" trade-mark in that class of merchandise, to be used on cigars, for instance, for another applicant. Nor would the first registrant be obliged to apply for a new registration if he should desire to extend the use of his trade-mark to cigars, or chewing tobacco, or any



THE TRADE-MARK OF THE GENERAL ELECTRIC COMPANY. AN EXCELLENT USE OF INITIALS AS A TRADE-MARK.

other tobacco product. The law would protect him in the use of the mark for all articles of that class, but the rules of the Patent Office require applicants to give full particulars not only as to class of merchandise, but the specific articles on which the mark has been used.

A result of the principle of trade-mark practice which limits the use of a mark to one class of merchandise is to be seen in the same name being used as a registered mark for unrelated articles.

The name "Pompeian," for instance, is used as a trade-mark for a face cream and also for wire netting for window screens; "Republic" is used for automobile tires as well as several other articles in different classes; "Packard" for pianos and automobiles; and there is an "Ideal" hair-brush and an "Ideal" fountain pen.

The law directs that the owner of a registered trade-mark affix, print or impress upon such trade-mark wherever it is used, or in close enough proximity to it to be easily seen, the words, "Registered in U. S. Patent Office," or the shorter abbreviated form, viz., "Reg. U. S. Pat. Off." The trade-mark of Baker's Cocoa—the Baker chocolate girl—reproduced on this page, shows how this should be done.

If this notification is not used in connection with the trade-mark, the owner of the mark, in infringement proceedings against an unauthorized user, cannot collect damages unless he can prove that he gave the other party formal notice, and that the unauthorized use of the mark was continued after notice.

A trade-mark is not merely an advertising symbol. It is an essential of trade-mark validity that the mark be affixed to the goods. A device, or word, or phrase, or picture that is used only in circulars, advertisements, or on signs or letter-heads is not a trade-mark and cannot be protected under the trade-mark laws. (It should be stated here that the unauthorized use of one other than the owner of such a device or wording may sometimes be prosecuted under the common law—the law of unfair business competition.)

A trade-mark may be printed, pasted, written, stamped, stenciled, branded, sewed, or woven upon the article with which it is used. In cases where it is not practicable to affix the mark upon the merchandise itself it must be affixed to the container.



Reg. U. S. Patent Office

A CELE-  
BRATED  
TRADE  
MARK.

### Rules of the Patent Office

We have not the space here to go into a detailed description of the procedure of the Patent Office in considering trade-mark applications. This procedure, especially in cases where there is some doubt as to the validity of the mark, is highly complicated,

and can be followed successfully only by a solicitor experienced in trade-mark practice.

The rules of the Patent Office require applications for registration of trade-marks to be made in a certain conventional form. A drawing of the mark, of a certain specified size, must be submitted with the application. Proofs of the mark, as actually used, must also be forwarded as exhibits in the case.

If, on preliminary examination, the mark appears to be entitled to registration, a reproduction of it is printed at least once in the Official Gazette of the Patent Office. This publication must be at least thirty days prior to the date of registration.

The purpose of the publication of the mark in the Official Gazette is to allow opposition from any one who thinks its registration would conflict with his rights. Opposing an application is technically called an "opposition." An opposition serves to delay registration until the examiner in charge of interferences considers the evidence submitted.

Under certain conditions, rejected applications may, on appeal, be taken up to the Commissioner of Patents.

The number of rejected applications is very large. Under the law of 1905, the total number of applications up to May, 1912, was 62,500.



THE CELEBRATED TRADE-MARK  
OF THE VICTOR TALKING MACHINE.

The total number of registrations under the law is around 42,000. This means that more than 20,000 applications have been rejected in seven years. In other words, about two out of every three applications pass the gauntlet of Patent Office scrutiny, interference and opposition, and are registered.

Many of the defective applications fail because of a lack of competent advice in devising the proposed trade-marks, as well as because of inexperience in prosecuting the applications.

**Number of  
Rejected  
Applications**



## CHAPTER III

### Analysis of the Requirements for Registration

**I**N the preceding chapter we traced an outline of the main provisions of the Act of 1905—the Trade-Mark Law. We intend to take up in this chapter each clause of the law applying to registration, and show how it works in actual practice.

Great care should be taken by an applicant for registration of a trade-mark, or his attorney, to avoid conflict with a trade-mark that is already registered or already in use (even if not registered), provided that it is applied to the same class of merchandise as that of the applicant. Lack of caution in this respect has caused interminable annoyance and litigation, with consequent financial loss.

A trade-mark will not be registered if it is identical in design or wording with a known trade-mark already in use by another and applied to goods of the same descriptive qualities, or if it resembles a known trade-mark so closely as to cause confusion

In considering the question of conflicting marks, the Patent Office and the Federal courts hold that the test of similarity is whether the marks are sufficiently alike in appearance or wording, or sound, to mislead the average individual.

The word "Autola" as a trade-mark for cigars was held not registrable owing to a prior registration of the word "Auto-do" for the same class of merchandise. In this instance, registration was refused on the basis of resemblance in sound as well as in appearance.

"Lady Lee" having been registered as a trade-mark for shoes, "Lady Like" was refused registration in the same class.

"Certosa" as a mark for a brand of flour sufficiently resembled "Ceresota"—already registered—to cause its rejection.

"Powellton" failed registration as a trade-mark for coal, on the ground that another company's coal already bore the registered mark "Powell's Run."

"Sodafoam" was considered close enough in resemblance to "Sea Foam" (already registered in the same class) to cause its rejection.

"Uno" having been registered as a trade-mark for a medicine, an application for the registration of "Ino" in the same class was refused.

Registration is refused a trade-mark when it consists of words describing a symbolic or pictorial device which has already been registered; or *vice versa*, when the wording has been registered first, registration for the symbol is refused. For

**SNUGTEX**

ONE OF THE IN-  
NUMERABLE WORDS  
ENDING IN "TEX."  
TRADE-MARK USED ON  
BELTS

instance, the Patent Office has held that a trade-mark consisting of a conventional representation of a bouquet of flowers is identical in meaning with another mark consisting of the word "Bouquet," applied to the same class of merchandise. In either case, the goods would be called "Bouquet Brand."

Agreement among owners of conflicting marks is not recognized by the Patent Office. An interesting example of this occurred in the attempt to register the word "Nayassett."



THE TRADE-MARK OF CRYSTAL DOMINO SUGAR. NOTE THAT THE REGISTRATION OF A PICTORIAL REPRESENTATION OF A DOMINO, OR MASK, INCLUDES THE EXCLUSIVE USE OF THE WORD "DOMINO."

The word "Nassac" had already been registered for the same class of goods and the registration of "Nayassett" was refused on the ground of similarity. Soon afterward, the owner of the "Nayassett" mark made a new application, accompanied by the formal consent of the owners of the "Nassac" mark. The Commissioner of Patents held that the law did not provide for agreement between owners of conflicting marks, and the registration of

"Nayassett" was refused accordingly.

About two years ago a manufacturer in a Middle Western city became interested in a new metal polish and decided to put it on the market. After long consultation with advertising men and salesmen, a name was selected. This name was suggestive and short, with a snap to it, that made it stand out in the memory. Many thousands of labels were ordered and packages of the article were given to the traveling salesmen of the concern to be used in getting orders from retailers. Booklets and literature had been written and mailed, and the business was beginning to take shape, when, to the surprise of the manufacturer and his associates, his application for trade-mark registration was rejected by the Patent Office for the reason that the mark had already been registered. Then followed a hasty trip to a trade-mark attorney and a search of the Patent Office records was made. Investigation of the register showed that the same name had been registered by an Eastern concern for a metal polish some years ago. About this time a letter arrived from the attorney of the Eastern firm, with a statement to the effect that the owner of the trade-mark considered this unauthorized use of the mark an infringement and intended to take legal action in the matter. A month or two was spent in trying to make some arrangement with the Eastern concern, with the final result that the trade-mark had to be dropped, and something new devised.

In this case a full year was lost, and a considerable amount of money was wasted, by reason of the failure of this manufacturer to have a search made of the Patent Office records. He made the mistake of considering the matter of trade-mark registration a small detail, and trying to attend to it himself. A competent solicitor would have saved his fee a thousand times over in this case.



A trade-mark consisting of the insignia of the American National Red Cross is not registrable

This prohibition is not covered by the trade-mark law, but is one of the provisions of the Act of Congress incorporating the American National Red Cross (approved Jan. 5, 1905). The act of incorporation states that it shall not be lawful for any person or corporation to use in trade, or for purpose of advertisement, "the sign of the Red Cross" or "any insignia colored in imitation thereof," *unless such person or corporation was entitled to the use of such insignia at the time of the passage of the act.*

This exception, which was intended to safeguard the interests of those who had long used the Red Cross sign as a trade-mark, covers the Red Cross mark of the well known druggists' specialty house of Johnson & Johnson, the Red Cross labels used on a brand of shoes made by Krohn, Fechheimer & Company of Cincinnati, the Red Cross mattress manufactured by a Boston concern, and a few other users of this device.

**TEXACO  
MOTOR OIL**

ANOTHER EXAMPLE OF A TRADE-MARK ENDING IN "O." THIS IS A COINED WORD, MADE FROM "TEXAS" AND "COMPANY."

The law, as it stands, is rigidly enforced in regard to all new trade-marks containing Red Cross devices.

An unusual argument was made the basis of an application for registration of a label for a cough syrup, on which the emblem of the Red Cross was printed, accompanied by the words "Red Cross." When registration was refused, the applicant sought to amend the label by striking out the Red Cross emblem, while leaving the words intact. He argued that the Red Cross incorporation act prohibited only the use of the "sign of the Red Cross" and not the words. The application was rejected on the ground that it was an attempt to evade the spirit of the law.

A trade-mark is essentially an exclusive possession. When it ceases to be exclusive, it ceases to be a trade-mark, in the true sense. It is apparent, therefore, that an ordinary word, descriptive of the goods with which it is used, cannot be set aside as the exclusive property of any manufacturer, to the detriment of others producing merchandise of the same character. The wording of the law on this point is clear, and the Patent Office is strict in its interpretation. But despite this condition, many applications, destined to be rejected, are made every year for the registration of descriptive marks. We give here a few examples of trade-marks, refused registration on the ground of being descriptive.

The word "Kantleek" was refused registration as a trade-mark for a hot-water bag. The Patent Office examiner held that the word was composed of "Can't" (misspelled "Kant") and "Leak" (misspelled "Leek"), and that it was intended to convey the idea that this particular bottle could not leak. The

Trade-marks that are descriptive of the goods with which they are used, or of the quality or character of the goods, are not registrable

attorney for the applicant presented an argument to the effect that the word was composed of two German words, "Kant"

# RUBEROID

(Trade Mark Reg. U.S. Pat. Office)

ALTHOUGH THIS MARK HAS BEEN REGISTERED IT HAS BEEN DECLARED A DESCRIPTIVE WORD BY A FEDERAL COURT, AND THEREFORE NOT PROTECTABLE.

and "Leek," that had meanings quite different from the English words with the same sound. This contention was too subtle for the Patent Office to grasp, and registration was refused.

The word "Naphtha," used as a name for a soap with naphtha as an ingredient, was held to be descriptive, and therefore not

registrable as a trade-mark, to the exclusion of the goods of other manufacturers, although the owner had advertised it extensively.

"Mello" as a mark for chewing-gum was considered descriptive, being simply a misspelling of the word "mellow."

Many applicants for trade-mark registration seem to think that the mere misspelling of a descriptive word, or some fanciful device in lettering, will remove the word from the descriptive class. This is a belief that has no basis in fact, for no matter how a word is spelled or lettered, it is descriptive if it conveys information of a descriptive character.

For instance, the word "Bestok" was rejected as a misspelling of "Best Stock"; "Unxld" as a misspelling of "Unexcelled"; "Kid Nee Kure" as a misspelling of "Kidney Cure"; and "Pittsburgh Pump," printed with hyphens between the letters—P-I-T-T-S-B-U-R-G-H P-U-M-P—was refused registration as being both descriptive and geographical.

The courts have held that the word "Elastic," used to designate drawers having an elastic seam,

"*Youngfello*"  
Reg. U.S. Pat. Off.  
**Clothes**

A CLOTHING TRADE-MARK. THE MISSPELLING OF THE PHRASE "YOUNG FELLOW" DOES NOT INCREASE ITS VALUE AS A TRADE-MARK. ITS ELIGIBILITY FOR REGISTRATION WOULD BE THE SAME IF IT WERE CORRECTLY SPELLED AND PRINTED IN ORDINARY TYPE.

is descriptive, but the same word is used in a fanciful sense and is valid as a trade-mark when applied to sectional bookcases.

A manufacturer of hooks and eyes applied for registration of the phrase "Rust? Never!" as a trade-mark. Registration was refused, as the mark was held to be descriptive, indicating that the hooks and eyes would never rust.

Arbitrary numbers are obviously registrable as trade-marks, but the applicant must be prepared to establish his contention that the numbers are really arbitrary and meaningless. In certain trades numbers are used to designate grades of a product common to the trade, and, in that case, the grade numbers are descriptive by common usage. A plow manufacturer applied for registration of the symbols "A No. 1," "No. 1" and "A X No. 1," as trade-marks for plows. It was shown, upon

examination, that these symbols are used by many plow makers to designate grades, and they were, therefore, ordinary descriptive trade terms. Registration was refused.

The prohibition against trade-marks descriptive of the character or quality of the product applies with equal force to trade-marks descriptive of the container or package. A flour manufacturer put up his product in barrels of a distinctive character—white and dark staves alternating. He applied for registration of a mark consisting of a pictorial representation of the striped barrel. This mark was considered descriptive, and registration was refused.

A Philadelphia candy manufacturer applied for registration of the word "Fussy," as used in the phrase "A fussy package for fastidious folk." The Patent Office held that the word "fussy," as used in the phrase, was merely a descriptive term—an adjective qualifying "package"—and registration was accordingly refused.

The word "Spearmint," being a descriptive word, was refused registration as a trade-mark for Wrigley's Spearmint chewing gum, but the representation of a spear was considered registrable.

Various applicants have sought registration for trade-marks that, while they are meaningless to English-speaking people, are really descriptive terms taken from foreign languages. Such words are not registrable, for the Patent Office makes no distinction between languages.

The phrase "Lait de Violettes," meaning in French "Milk of Violets," was rejected as a mark for perfumery.

"Elegancia," the Spanish equivalent of the English word "Elegant," was refused registration as a trade-mark for cigars.

A descriptive word in a language as little known as Esperanto is nevertheless unregistrable. "Saniga" means "Sanitary" in Esperanto, and it has been accordingly refused registration on the ground of being a descriptive term.

In considering the question of descriptive marks, the difference between *description* and *suggestion* should not be overlooked. Suggestiveness is a highly desirable quality in a trade-mark, and many excellent and legally valid marks are suggestive.

The name "Hydegrade," a registered trade-mark, applied to a well-known fabric, is suggestive of high quality, but it is not descriptive. It is a coined word, composed of the elements "Hyde" (name of owner) and "Grade."

Another example of an excellent suggestive mark is "Rubdry" applied to towels.

**"Cravenette"**  
REG. U. S. PAT. OFF.

IT IS NOT GENERALLY KNOWN THAT THIS IS AN ARBITRARY WORD, REGISTERED AS A TRADE-MARK.

**"STEERO"**  
(Reg. U. S. Pat. Off.)

A WELL-KNOWN TRADE-MARK. ANOTHER EXAMPLE OF THE LARGE NUMBERS OF MARKS CONSISTING OF WORDS ENDING IN "O"

Pictorial marks are often highly suggestive without being descriptive. The Baker Chocolate girl, depicted in the act of serving a cup of cocoa, suggests *daintiness, taste, beverage, quickness in serving, and refreshment.*

The word "Ideal," used in connection with a fountain pen, is considered fanciful, and not descriptive. It would seem that a very fine distinction is made here, as this word is an ordinary descriptive word, commonly used to express a state of perfection, as in the expression "An ideal day." It may be said, on the other hand, that nothing ever reaches an ideal condition, and, in that sense, the mark may be considered fanciful.

Geographical names, like descriptive terms, are the common property of all who use the language. No one manufacturer can appropriate such a term for his own exclusive use as a trade-mark unless he uses it in an arbitrary or fanciful sense. The only exceptions to this principle are to be found in the case of manufacturers who have adopted geographical terms as their trade-marks and have used them so long, without opposition or protest, that they have acquired a common law right to their exclusive use.

Among the geographical marks rejected by the Patent Office are the following:

"Yale," applied to hosiery; "Cloverdale," for canned fruits and vegetables; "Red River Special" as a mark for agricultural implements; and "Aurora," on shoes—the name "Aurora" being applied to localities in at least twenty states of the Union.



A GOOD EXAMPLE OF THE USE OF A SUGGESTIVE SYMBOL AS A TRADE-MARK, USED IN CONNECTION WITH BAY STATE BRICK AND CEMENT COATING.

It would seem in the light of common-sense, that in the last-named case (that of "Aurora") the ruling of the Patent Office is on a very narrow basis indeed. The word "Aurora" has no geographical significance to the average person. It calls up a mental image of the dawn. If this case, and some others like it, are considered valid precedents, every applicant for trade-mark registration must be prepared to submit his application to the stern criticism of the Post Office Directory, with its catalogue of fifty thousand or more names. (It is interesting to observe that, in a later case, the Patent Office allowed the registration of "Aurora" as a trade-mark for oils, lard, syrup and honey. *Aspegren & Co., ex parte*, 100 *Official Gazette*, 684.)

"Tabasco" was refused registration as a mark for a sauce on the ground that it is a geographical term, Tabasco being the name of a state in Mexico.

"French" was rejected as a trade-mark for paint. On the other hand, "Celtic" has been registered as a trade-mark for tea



The word "Celtic" has reference to a race, of which the Irish are only one branch. It is not applied to any particular country or section of the globe.

The map of the United States has been refused registration as a trade-mark for sugar.

"American Lady" was refused registration on the ground that the word "American" is geographical.

When a geographical term, applied to merchandise, is used in a fanciful or arbitrary sense—that is, when it conveys no deception in regard to the origin of the merchandise—it may be registered as a valid trade-mark.

"Dublin" is a valid trade-mark for soap, although the soap is made in America. In the case concerning this mark it was shown that it is the practice of soap manufacturers to call their products "Limerick," "Scotch," "Irish," etc., and that the buying public is aware of the fanciful use of these names and is not deceived thereby.

"Vienna," applied to bread, is considered valid. No one expects bread made in Vienna to be sold in America, consequently no one is deceived by this fanciful use of the word.

"Gibraltar" is registered as a trade-mark for belting. It is true that Gibraltar is a geographical name, but its suggestiveness in regard to belting conveys the mental picture of strength, rather than the idea of origin.

The student of trade-mark conditions, having learned how rigorously the Patent Office interprets the section of the law applying to the registration of geographical terms, will perhaps be puzzled by the number of trade-marks of this class which seem to be valid and well-established.

The explanation of that is that many geographical names, which could not have been protected *ab origine* as trade-marks, have acquired a secondary meaning by long and exclusive use by a particular manufacturer. Such marks fall within the protection of the common law.

Some of these common law marks are registered under the ten years' clause.

Among well-known geographical trade-marks may be mentioned "Bristol" applied to fishing-rods; "Kalamazoo" applied to stoves; "Manhattan," the name of a brand of shirts; and "Elgin," "Waltham," and "Illinois," the names of watches.

The U. S. Sanitary Manufacturing Co. was refused registration for a trade-mark consisting of the letters "U.S." with a background of a shield similar to that of the conventional United States shield.

# Necco

THE TRADE-MARK OF THE NEW ENGLAND CONFECTIONERY COMPANY. THIS IS A COINED WORD, MADE UP FROM THE FIRST LETTERS OF EACH WORD IN THE CONCERN'S NAME.

# "Bristol"

**Bait Rods**

A GEOGRAPHICAL NAME REGISTERED UNDER THE TEN-YEARS' CLAUSE.

The coat of arms of the United States is not registrable as a trade-mark even under the ten years' clause. It has been held that its use in that connection is opposed to public policy. (*American Glue Company, ex parte*, 120 *Official Gazette*, 324.)

A trade-mark must not consist of the flag or coat of arms or other insignia of the United States, or of any state, or municipality, or any simulation thereof

The registration of the coat of arms of the state of Maryland was refused registration, application having been made under the ten years' clause.

In another case, registration of a simulation of the shield of the United States, with alternate red and white stripes, was refused registration.

It would seem at first consideration that if the object of using a trade-mark is to indicate the origin of a commodity, the most effective mark would be simply the maker's name—"James Brown" for goods made by James Brown, and "William Jones" for goods made by William Jones.

A trade-mark which consists merely of the name of an individual, firm or corporation can be registered only on certain conditions

This logic would be indisputable if there were a different family name for every individual. But names are limited in number—there are eleven pages of Smiths in the New York City Directory—and every man has a natural and inalienable right

to use his own name. It is obvious that a family name lacks the exclusiveness that is an essential quality of a legitimate trade-mark.

But a personal name may be written, or printed, or stamped in such a way that the peculiarities

**NESNAH**

THIS TRADE-MARK OF A JELLY POWDER IS A COINED WORD, MADE BY SPELLING THE PROPRIETOR'S NAME "HANSEN" BACKWARDS

of writing, or printing, or design, may dominate the name and be the most conspicuous feature of the combination.

The trade-mark Act provides that "no mark (shall be registered) which consists merely in

the name of an individual, firm, corporation, or association, not written, impressed or woven in some particular or distinctive manner, or in association with a portrait of the individual." In this clause the framers of the Act have endeavored to put a logical restriction on the injudicious use of personal names as



trade-marks and the endless litigation that has always resulted from this practice.

WITHIN THE MEANING OF THE STATUTE THIS WAY OF PRESENTING THE NAME "GILLETTE" IS CONSIDERED DISTINCTIVE. NOTE THAT THE DEVICE DOMINATES THE NAME, AND PUTS IT INTO A POSITION OF RELATIVELY SECONDARY IMPORTANCE.

The names of historical personages (not living) may be registered as trade-marks, but the name of a living person cannot be used without his consent.

The phrase "Gibson Girl" as a mark for shoes was refused registration, as the word "Gibson" obviously referred to Charles Dana Gibson, a living artist.

In case of the registration of names of individuals, firms or corporations the restriction of the law that the name must be shown in some "particular or distinctive manner" has been interpreted to mean a presentation of the name in such a form that the peculiarities of lettering, or writing, or of an accompanying device are so pronounced that they dominate the name and throw it into a position of secondary importance. The meaning of this clause is best shown by means of examples of proper names, registered and used as trade-marks. A number of trade-marks of this character may be found in this book.

Many portraits of living persons are used as trade-marks—notable among them being the face of W. L. Douglas,

A portrait of a living individual is not registrable as a trade-mark unless the application is accompanied by the written consent of the person whose portrait is used

shoe manufacturer; and the portrait of Thomas A. Edison, used in connection with his facsimile signature, as a trade-mark for Edison phonographs.

Among historical characters the picture and signature of Robert Burns, the poet, are combined in a trade-mark for cigars; the face of Benjamin

Franklin is used as a trade-mark for the Saturday Evening Post, and will be found printed on the editorial page of each issue; Bismarck is a name for collars; Napoleon is used in connection with a brand of flour; and "Bob" Ingersoll is the trade-mark of a cigar.

It is a definite principle of the common law that fraud vitiates any transaction that it touches. A trade-mark that is deceptive and misleading cannot be protected, no matter if its registration should be accomplished.

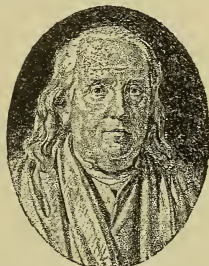
"Knights of Labor" was refused registration as a trade-mark for whiskey, as the evident intent of the mark was to mislead purchasers into a belief that the whiskey was produced by the Knights of Labor, a labor organization.

A trade-mark is not registrable if it conveys in any way a misrepresentation of the article

A similar case is exhibited in the attempt to register the name "Masonic" as a mark for cigars. Registration was refused.

The name "Malt Myrrh" was refused registration as a trade-mark for malt liquors when it was shown that the liquors did not contain myrrh.

The name "Old Country Soap," used in connection with soap in such a way as to lead purchasers to believe that the soap was manufactured in Europe, was held by the court in the case of *Wrisley v. Iowa Soap Company* to be deceptive, and protection against infringement was refused.



REG. U. S. PAT. OFF.

THIS PORTRAIT OF BENJAMIN FRANKLIN IS THE TRADE-MARK OF THE SATURDAY EVENING POST.



A false representation on a trade-mark to the effect that the article is patented when it is not, is sufficient to vitiate the trade-mark.



AN AUTOMOBILE  
TRADE-MARK.

A trade-mark registration does not protect when it is used on an article different in character, or composition, or origin, from that for which it was registered. This principle is very important. A manufacturer cannot do as he pleases with his trade-mark without regard to the rights of the public. If the article for which it was registered is changed essentially in composition, or in purpose, the trade mark ceases to be of value. Trade-marks under the United States law are always *specific and associated with a certain definite article*, and not with the proprietor's general business.

In Great Britain and Canada there are *general trade-marks*, which a manufacturer may use on any article he makes, no matter to what diverse classes these articles belong.

A trade-mark which is technically a valid mark, will be refused registration if, in the opinion of the Patent Office, its registration would be opposed to public policy. A few examples will show what we mean. The phrase "Ask the Revenue Officer" was rejected as a mark for whiskey. The Patent Office held that this mark, appearing on bottles or barrels, would lead the public to believe that the contents had the indorsement of officers of the government.

For a similar reason the word "Government" was refused registration as a mark for loose-leaf binders.

The name of a living Ex-President cannot be registered without his written consent (as in the case of any other living person), and the name of an Ex-President, not living, cannot be registered at all. The use of the name of an Ex-President as a trade-mark is not considered consonant with the high dignity of the Presidential office.

Several applications have been made within the last few years for registration of the names or portraits of Ex-Presidents.

The signature and portrait of Thomas Jefferson, combined in a trade-mark for cigars, was refused registration.

The words "Roosevelt Rose" were rejected on application for registration, the rejection being partly because "Rose" had been registered on a previous application, and partly because Roosevelt is a living person.

A trade-mark cannot be a color, because the number of colors is limited, and it would be manifestly unfair to give the exclusive use of a color to any individual.

The use of the flag or coat of arms of any foreign power is prohibited as a trade-mark. This restriction holds even when the foreign power agrees to the use of its insignia. The

A trade-mark  
is not regis-  
trable if its  
registration  
would be  
against public  
policy

**Other  
Restrictions**

Russian government consented to the use of its coat of arms as a trade-mark in the case of an applicant before the United States Patent Office, but registration was refused. The law is mandatory, and is not affected by agreement.

Any design or picture which has been adopted by a fraternal society as its emblem is not registrable as a trade-mark.

For obvious reasons, scandalous or immoral matter is refused registration.

A trade-mark cannot be a shape, or a package, or a container.

A trade-mark cannot be the article of merchandise itself, for the "mark" must necessarily be different from the thing marked.

**JELL-O**

THERE ARE SO MANY  
TRADE-MARKS ENDING IN  
"O"—SUCH AS CRISCO, OMO,  
ONOTO, QUIXO, PEBECO—  
THAT MARKS OF THIS TYPE  
NO LONGER POSSESS DIS-  
TINCTIVENESS

## CHAPTER IV

### The Elements of a Good Trade-Mark

**T**HE reader who has perused the preceding pages devoted to a discussion of what a trade-mark cannot be, begins to wonder, perhaps, what part of the language is left unrestricted.

It is true that the number of restrictions imposed by the law and the courts is considerable, but the language is virtually inexhaustible, with its infinite possible combinations of letters and words. And to these possibilities of construction must be added the limitless varieties of designs and symbols which are registrable and valid under the law.

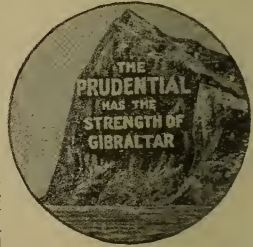
A trade-mark may be:

A *coined word*, like Calox, Coca-Cola, Omo, Jap-a-lac, Crisco, Pebeco, Celluloid, Plexo (a trade-mark for suspenders; also for a toilet preparation), Sapolio, Cravenette, Jell-O, Kodak, Uneeda, Pro-phy-lac-tic, Crex and Quixo.

A *symbol*, like the Baker chocolate girl; the Prudential Insurance Company's trade-mark, which consists of a picture of the Rock of Gibraltar; the Merrimack duckling; the spear of Spearmint chewing gum; the Puritan painter, used on Bay State brick and cement coating; the Ford automobile mark, consisting of a winged pyramid; or the representation of a mask or domino, used on packages of Crystal Domino sugar; or the painter boy of the National Lead Company.

A *combination of a word, or words, and a symbol*, like Thomas A. Edison's portrait and signature, used in connection with phonographs; a picture of a black cat and the words "Black Cat," used as a hosiery trade-mark; the trade-mark of the Vacuum Oil Company, consisting of a picture of a gargoyle in connection with the word "Gargoyle"; or a representation of a swan accompanied by the word "Swan," used on fountain pens.

A *portrait*, like Mennen's Talcum Powder mark, which is a picture of Gerhard Mennen; or the portrait of Robert Burns, used on cigars.



THE ROCK OF GIBRALTAR HAS LONG BEEN THE TRADE-MARK OF THE PRUDENTIAL INSURANCE COMPANY. IT APPEARS ON PRUDENTIAL POLICIES, AND IS USED IN CONVENTIONAL TRADE-MARK FORM.



A TRADE-MARK OF THE VACUUM OIL COMPANY.

A word, or words, used in a fanciful (non-descriptive) sense, like "Cat's Paw," a trade-mark for rubber heels; "Bachelor's Friend," a suggestive trade-mark for hosiery; the word "Ribbon," a mark for a tooth-paste; "Republic," used on automobile tires; "Velvet," a trade-mark for smoking tobacco; "Onyx," the trade-mark of a well-known brand of hosiery; "Ivory," which stands for a famous brand of soap; "Diamond," a name for tires; "Arrow," used on collars; "Blue-Jay," a trade-mark for a corn-plaster; "Big Ben," used on alarm clocks; "Lifebuoy," the name of a soap; or "Occident," the name of a flour.



THE TRADE-MARK USED ON HEISEY GLASS-WARE.

A historical or mythological character, like Juno, King William, Stonewall Jackson, Cupid, Venus (there is a lead pencil carrying this trade-mark), Samson (applied suggestively to a brand of rope), or Apollo (the name of a piano-player).

Initials or arbitrary numbers, like the "G.E." trade-mark of the General Electric Company; the number "4711," applied to perfumery and toilet articles; "61," a floor varnish; "E-Z," the suggestive trade-mark of jar used in preserving fruits; "O.K.," the name of a clip to hold papers together; "B.V.D.," the trade-mark of a well-known line of underwear; or the big "H" enclosed in a diamond-shaped design, used as a trade-mark on Heisey's glassware.



The business name of person, firm or corporation when written, printed, impressed or woven in a distinctive manner, or in association with a portrait, or in an autographic form. An example of this type of trade-mark is the word "Cross," reproduced here. The name "Gillette," used on safety razors, is enclosed in a diamond and crossed by an arrow. A well-known trade-mark of this character is the name "Stewart Hartshorn," found on most shade-rollers.

Marks that may be technically defective are registrable under the ten years' clause if they have been in exclusive use by the applicant for ten years preceding 1905. The word "Faultless,"



A VERY EFFECTIVE TRADE-MARK, USED WITH BISCUITS SOLD IN PACKAGES.

registered by E. Rosenfeld & Company, of Baltimore, as a trade-mark for garments, belongs to this class. "Faultless" is, of course, descriptive, but it is nevertheless registrable under the ten years' clause. Another mark of the same kind consists of the word "Coward"—a trade-mark for shoes.

Coward is the proprietor, and under the Act of 1905 his name has no eligibility as a trade-mark unless it is written or printed in a distinctive manner. But his name has been used as a trade-mark since 1868, and, consequently, falls within the provisions of the ten years' clause.

It is easy enough to devise a trade-mark that will comply with the letter and the spirit of the law. But a trade-mark should be something more than merely registrable and protectable. Think of the immense advertising and selling effort that must be brought to bear to overcome the inertia of a meaningless or unsuitable trade-mark.

**The Nine Tests of a Desirable Trade-Mark** A proposed trade-mark should not be adopted until every one of the following questions can be answered affirmatively in regard to it:

1. Is it easy to speak?
2. Is it easy to remember?
3. Is it easy to spell?
4. Is it simple in design?
5. Is it attractive in sound and appearance?
6. Is it suggestive of the good qualities of the merchandise?
7. Is it different from other trade-marks of the same class?
8. Can it be affixed to the goods with which it is to be used?
9. Is it registrable and protectable?

Few trade-marks in commercial use can stand these tests, because most marks have been designed without any clear perspective of the part they were to play in business.

As a matter of interest and instruction, let us take several well-known trade-marks, at random, and put them through the list of test questions.

Opening a current magazine, the first trade-mark we see is "Postum," the name of a substitute for coffee. Postum is easy to say and remember and spell. It is simple, but not particularly attractive in sound. It has no suggestiveness, except the artificial suggestiveness of familiarity. It is distinctive, registrable, and is virtually infringement-proof. If the figure 100 should be set down as denoting a perfect trade-mark, then Postum should be graded at about 80. It wholly lacks suggestiveness, and it is not attractive though not displeasing.

The next mark that attracts our attention in this magazine is "Siwelclo," a coined word, applied to a flushing device used in connection with bathroom toilets. Siwelco is not easy to pronounce, it is not euphonious, it is not easy to remember or to spell. It is the reverse of attractive in sound, and it carries no suggestiveness. It is registrable and protectable.

The next trade-mark is "O.K.," applied to paper fasteners. This mark possesses every good feature. It is suggestive in the



A TRADE-MARK FOR LUBRICATING OIL.



sense that "O.K." means, in ordinary speech, "all right, satisfactory, good." These fasteners are used in offices. The symbol "O.K." has a distinct meaning in commercial language. We are of the opinion that "O.K." used as a trade-mark for office supplies should be graded 100.

"Cat's Paw," a trade-mark for rubber heels, is the next. It is an example of a word that is suggestive in the wrong way. "Cat's Paw" suggests the soft, quiet tread of a cat—and of rubber heels. At first glance it would seem that "Cat's Paw" is an ideal name. But those who sell rubber heels say that the noiseless tread (or "sneaky walk," as one shoemaker stated it) is the greatest of all drawbacks to the sale of rubber heels. In short, the name is suggestive, but suggests a defect.

The next trade-mark that comes to hand is the Ford automobile mark, reproduced on this page. It should be noted at the start that the mark as it stands, with the phrase "The Universal Car" as a part of it, is not registrable, as it contains a descriptive phrase. The rest of the design is registrable, and, after registration, the descriptive phrase might be imposed upon it without destroying its validity.



THE FORD AUTOMOBILE  
TRADE-MARK—A PYRAMID  
WITH WINGS.

In considering this mark the reader should bear in mind that an automobile trade-mark must be of such character that it can be worked out in metal and attached to the front of the radiator. The Ford device is suited to this form of affixation.

This trade-mark shows a pyramid with wings. Its symbolism is the pyramid for *strength and solidity*, and the wings for *speed*. *Speed* and *solidity*—two desirable qualities in an automobile. The symbolism is not apparent until explained, and the mark is rather meaningless to the ordinary observer, but, considering the restrictions that surrounded its creation, we are of the opinion that it is a very good trade-mark.

Next we come to "Rallo," which is the trade-mark of a collar-retainer. The word is obviously the word "Collar" spelled backward. It is not euphonious, or attractive, or distinctive in any way. This mark is an example of a large class of trade-marks which bears upon them the evidences of only one purpose—and that is, to produce something which will not be rejected by the Patent Office.



A REGISTERED TRADE-  
MARK WHICH IS SO SUG-  
GESTIVE THAT IT APPROACHES  
WITHIN A HAIR'S BREADTH  
OF BEING DESCRIPTIVE.

"Crex" is an excellent trade-mark. It is an adaptation of the word "Carex," which is the botanical name of a sedge-like grass which may be woven into a fabric. Dropping the "a," we have "Crex." This name sticks in the memory; it is easy to spell, easy to say, and is quite distinctive. It lacks inherent suggestiveness, but it is the kind of word that may be readily popularized by advertising.

There is a toilet preparation widely advertised and sold under the name "Sempre Giovine," meaning "always young." This trade-mark must be a tremendous drawback to the success of the article with which it is associated. It cannot be pronounced properly except by those who have taken lessons; and it is difficult to remember. To an English-speaking person it conveys no suggestion. Foreign words should be avoided in devising trade-marks. People do not like to ask for things by names which they cannot pronounce.

The trade-mark affixed to the linens sold by McCutcheon, of New York, a store famous for the quality of its fabrics, consists of the picture of an old-fashioned spinning-wheel, without wording. This is a very good trade-mark. It brings up a mental picture of the slowly-wrought hand-woven linens of our grandmothers' time, fabrics that looked good and wore well.

There are trade-marks so admirably adapted to their purpose that they seem to be the work of genius. "Uneeda," applied to crackers in a sealed package, is such a trade-mark. "Rainbow," a trade-mark for dyes, is another happy inspiration. This name makes one think of the fine colors and delicate tones of a rainbow. It stimulates the idea that these dyes emulate a rainbow in beauty. "Skidoo"—a trade-mark used in connection with a small gasoline engine for launches—is another trade-mark that touches the top notch of merit. It suggests agility and lightness, and the ability to get in motion and scurry away.

### Special Notice

An enormous waste of mental effort expended by manufacturers and their representatives in devising unsatisfactory trade-marks might be avoided by consultation with us—either personally or by mail—before any work is done in the way of devising a mark.

There are more than 40,000 registered marks in existence, and approximately 100,000 unregistered trade-marks that have been used long enough to be capable of protection under the common law. One can see that the chances are large of a new trade-mark user deciding upon a mark that is already in use. Many marks are sent to us to be registered on which it is evident that much thought has been expended, but which are so nearly like other marks already in existence that their registration and protection are impossible.

A search of the Patent Office files, for which we charge only \$5.00, generally saves many times its cost in mental work and vexation.



TRADE-MARK OWNED BY  
THE KALAMAZOO SUSPENDER  
COMPANY. IT IS A COINED  
WORD, THE ELEMENTS OF  
WHICH ARE TAKEN FROM THE  
NAME "KALAMAZOO."



## CHAPTER V

### PART I.

## INFRINGEMENT

### I.

### Trade-Marks Defined

Many clear and terse definitions of trade-marks are to be found among various decisions rendered by both the Federal and State courts of this country; for instance, in *Ball vs. Broadway Bazaar*, 87 N. E. 674, the Court of Appeals of the State of New York says:

"A trade-mark may be tersely defined to be any sign, mark, symbol, word or words, which indicate the origin or ownership of an article as distinguished from its quality, and which others have not the equal right to employ for the same purpose. In its strictest sense, it is applicable only to a vendible article of merchandise to which it is affixed."

In *G. W. Cole Co. vs. American Cement & Oil Co.*, 130 F. 703, the Court of Appeals for the Seventh Circuit said:

"A trade-mark is an arbitrary distinctive name, symbol or device, to indicate or authenticate the origin of the products to which it is attached."

In *Galena Signal Oil Co. vs. W. P. Fuller & Co.*, 142 F. 1002 the Court said:

"The symbol or device which one is at liberty to affix to a product of his own manufacture as a trade-mark must be one not previously appropriated, and which will distinguish the article from one of the same general nature manufactured or sold by others."

### II.

### Trade-Mark Statutes

(Secs. 16, 17, 19, 20, 21, 23, 27, 28.)

#### Effect of Registration:

SECTION 16. That the registration of a trade-mark under the provisions of this act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a

verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

#### **Jurisdiction of Courts:**

SECTION 17. That the circuit and territorial courts of the United States and the supreme court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the court of appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this act, arising under the present act, without regard to the amount in controversy.

#### **Injunctions, Damages and Accountings:**

SECTION 19. That the several courts vested with jurisdiction of cases arising under the present act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

SECTION 20. That in any case involving the right to a trade-mark registered in accordance with the provisions of this act, in which the verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trade-mark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted upon hearing, after notice to the defendant, to prevent the violation of any right of the owner of a trade-mark registered in accordance with the provisions of this act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other circuit court, or judge thereof, in the United States, or by the supreme court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the circuit court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

#### **Fraud and Misrepresentation:**

SECTION 21. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

**Common Law Rights:**

SECTION 23. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

**Custom House Registration:**

SECTION 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

**Notice:**

SECTION 28. That it shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

**Red Cross Insignia:**

ACT TO INCORPORATE THE AMERICAN NATIONAL RED CROSS,  
APPROVED JANUARY 5, 1905 (AS AMENDED JUNE 23, 1910).

SECTION 4. That from and after the passage of this act it shall be unlawful for any person within the jurisdiction of the United States to falsely or fraudulently hold himself out as or represent or pretend himself to be a member of or an agent for the American National Red Cross for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of or an agent for the American National Red Cross. It shall be unlawful for any person, corporation, or association other than the American National Red Cross and its duly authorized employees and agents and the Army and Navy sanitary and

hospital authorities of the United States, for the purpose of trade or as an advertisement, to induce the sale of any article whatsoever or for any business or charitable purpose to use within the territory of the United States of America and its exterior possessions the emblem of the Greek Red Cross on a white ground, or any sign or insignia made or colored in imitation thereof, or of the words "Red Cross" or "Geneva Cross" or any combination of these words: *Provided, however*, That no person, corporation, or association that actually used or whose assignor actually used the said emblem, sign, insignia, or words for any lawful purpose prior to January fifth, nineteen hundred and five, shall be deemed forbidden by this act to continue the use thereof for the same purpose and for the same class of goods. If any person violates the provision of this section he shall be deemed guilty of a misdemeanor, and upon conviction in any Federal court shall be liable to a fine of not less than one or more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense.

### III.

#### Statute vs. Common Law

It should be clearly understood that the right to own a trade-mark or trade-name has not been created by statute, for the use of trade-marks and their protection antedates any legislation affecting this subject of jurisprudence. The Supreme Court of the United States, speaking of the relation of trade-marks to legislation, in *United States vs. Steffens, et al*, 100 U. S. 82-100, says:

"The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law and the chancery courts of England and this country. . . . It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long and anterior to that Act (*viz.*, Act of July 8, 1870), and have remained in full force since its passage."

See also Section 23 Trade-Mark Laws of 1905, at p. 3.

### IV.

#### Effect of Trade-Mark Act

The effect of registering a trade-mark in accordance with the Trade-Mark Laws of the United States, enacted February 20, 1905, is as follows:

1. It creates a permanent record of the date of adoption and use of a mark, which in any suit is *prima facie* evidence of ownership. Therefore, should litigation arise between the owner of a registered mark, and one who is the owner of a non-registered mark,

the burden of proof is on the latter to establish priority of adoption and use. This is often very difficult to do, especially where a trade-mark has been in long use, as such proof must necessarily rest on the production of old labels, cartons, packages of the goods with the trade-mark attached, order books, and the testimony of witnesses.

2. It gives jurisdiction to the Federal Court irrespective of the amount in controversy or the place of residence of the parties. This is of decided advantage owing to the fact that an injunction secured in one Federal Court will be enforced in all such courts throughout the United States, and further, the owner of a registered mark is afforded the privilege of recording his trade-mark with the various United States Custom Houses to prevent the importation of goods bearing an infringing mark. An action where neither litigant is the owner of a registered trade-mark must be brought in a state court, unless there is a diversity of citizenship between the contesting parties and an amount of more than \$3,000 involved.

3. It allows treaty stipulations entered into between the United States and foreign countries for the benefit of the owners of trade-marks to be carried out.

## V.

### **Trade-Marks and Trade-Names Distinguished**

A trade-name can be distinguished from a trade-mark in that the former is either a word or combination of words serving to distinguish a certain manufacturer or merchant and his specific merchandise, which word or words, although not capable of exclusive appropriation nor registrable in the Patent Office as a technical trade-mark will nevertheless be protected within certain limits by the Courts from general use by competitors through the doctrine of unfair competition; while on the other hand, a technical trade-mark is capable of exclusive appropriation, can be registered in the United States Patent Office, and an infringer may be proceeded against under the provisions of the Federal Trade-Mark Statutes.

On this subject the Court of Appeals stated in *Wolf Bros. & Co. vs. Hamilton-Brown Shoe Co.*, 165 F. 413, 91 C.C.A. 363:

"While it is true that a geographical name may not be exclusively appropriated as a trade-mark, yet a party having adopted a geographical name as a designation of his goods, may be protected as against unfair trade. . . . In this case, while the complainant is not entitled to relief upon the grounds that the words 'The American Girl,' or the numerals applied to its several styles of shoes, are valid trade marks, yet it is entitled to protection



from their use by the defendant in a manner and under circumstances constituting unfair trade, the essence of the rule being that one person shall not, in the sale of his goods, so act as to lead the public to believe that they are the goods of another."

See also *Northwestern Knitting Co. vs. Garon*, 128 N. W. 288, and *Wolf Bros. & Co. vs. Hamilton-Brown Shoe Co.*, 192 F. 930.

Such words, therefore, as "Wanamaker," "Hygeia," "The American Girl," "Flare Front," "Waltham," etc., are trade-names which will be protected by Courts of Equity, through the application of the law of unfair competition, while "Kodak," "Coca Cola," "Jell-o," etc., are trade-marks capable of Federal registration, and infringers may be proceeded against directly under the provisions of the Trade-Mark Statutes.

## VI.

### Proper Names as Trade-Marks

Any one has the right to honestly use his own name in connection with his business, even though this use should interfere or injure the business of another, provided, however, that he uses every reasonable means he can to distinguish his own business, and the merchandise which he places on the market from those of his competitor.

In *Royal Baking Powder Co. vs. Royal*, 122 F. 337, the Court of Appeals said:

"In view of the very plain purpose of the defendant to attack the business of the Royal Baking Powder Co. in an unfair way, and of the positive evidence of purchasers misled by the conspicuous way in which the name 'Royal' is displayed on the front label of defendant's cans, and of the evidence that it is not customary in the trade to display the maker's name on the front of the label, a majority of the Court think it right to extend the injunction so as to restrain the defendant from displaying his name on the front label of his cans. That the maker should have his name and address somewhere on the goods is right. We all agree with Judge Evans in refusing to restrain the defendant from in any way using his own name, but a majority think that the duty of so using it as to carefully distinguish the business carried on by him and the goods made by him, from the business done by the complainant and the goods made by them, demands that he shall present his his own name in the least conspicuous manner possible consistent with the right to place his name and address upon the goods made by him."

In *Stix, Baer & Fuller Dry Goods Co. vs. American Piano Co.*, 211 F. 271, the Court of Appeals in the Eighth Circuit said:

"It is now settled beyond controversy that a family surname is incapable of exclusive appropriation in trade. The right of every man to use his own name in his business was declared in the law before the modern doctrine of unfair trade competition had arisen. It is part of the law of trade-mark. The subject may, therefore, be properly approached from that side. If, however, the name has previously become well known in trade, the second comer uses it subject to three important restrictions: (1) He may not affirmatively do anything to cause the public to believe that his article is made by the first manufacturer. (2) He must exercise reasonable care to prevent the public from so believing. (3) He must

exercise reasonable care to prevent the public from believing that he is the successor in business of the first manufacturer. This duty to warn, however, must not be pressed so far as to make it impracticable for the second comer to use his name in trade. Otherwise we destroy under the law of unfair trade competition the very right which we have saved under the law of trade-mark."

See also *Von Faber vs. Faber*, 124 F. 603 and 139 F. 257; *Walter Baker & Co. vs. Sanders*, 80 F. 889; *Ball vs. Best*, 135 F. 434; *L. E. Waterman Co. vs. Modern Pen Co.*, 197 F. 534; *Thaddeus Davids Co. vs. Davids*, 192 F. 915; *Walter Baker & Co. vs. Gray*, 192 F. 921; *Williams Soap Co. vs. J. B. Williams Soap Co.*, 193 F. 384; *Wright Restaurant Co. vs. Seattle Restaurant Co.*, 67 Wash. 690; *International Silver Co. vs. Rogers*, 67 A. 105. *Wm. A. Rogers, Ltd. vs. International Silver Co.*, 34 App. D. C. 410; *National Distilling Co. vs. Century Liquor & Cigar Co.*, 183 F. 206; *Kaufmann vs. Kaufmann*, 123 N. Y. S. 699.

## VII.

### Names of Patented Articles

Upon the expiration of a patent on an article of merchandise, any trade-mark or trade-name that has been associated with the article in the sale thereof during the life of the patent, becomes public property. This doctrine is clearly expressed in *Singer Mfg. Co. vs. June Mfg. Co.*, 163 U.S. 169, where the Court, speaking by Mr. Justice White, said:

"The result, then, of the American, the English and the French doctrine universally upheld is this, that where, during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become by his consent, either expressed or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created. Where another avails himself of this public dedication to make the machine and use the generic designation, he can do so in all forms with the fullest liberty, by affixing such name to the machines, by referring to it in advertisements, and by other means, subject, however, to the condition that the name must be so used as not to deprive others of their rights or to deceive the public, and, therefore, that the name must be accompanied with such indications that the thing manufactured is the work of the one making it, as will unmistakably inform the public of that fact."

This doctrine was upheld and Mr. Justice White quoted in *Sternberg Mfg. Co. vs. Miller, Du Brul & Peters Mfg. Co.*, 161 F. 318.

In *National Lock Washer Co. vs. Hobbs Mfg. Co.*, 210 F. 516. the Court said:

"The defendant contends that this case is governed by the decision in *Singer Manufacturing Co. vs. June Manufacturing Co.*, 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118; that under the rule of that case, upon the expiration of the Harvey patent in 1903, the word 'National,' as applied to lock washers constructed under that patent, became public property, and that it had the right thereafter to make lock washers covered by the patent and to sell them under the designation of the National Pattern, provided it clearly indicated, as it did, that the article it dealt in was of its own manufacture; that neither the patentee nor his successor in title, the complainant, could acquire a monopoly in the word 'National'

on the theory that it had become a trade-mark denoting origin; that, whether it denoted origin or, by reason of its use during the existence of the patent, had become descriptive of the kind of washer manufactured thereunder, neither the patentee nor his successor could acquire a monopoly in the word by having it registered under the act of 1905 as a technical trade-mark, or as a descriptive word under the 10-year clause; and that its use under the patent, being a monopoly, cannot be availed of as proof for the purpose of extending the monopoly for an additional 20 years by registration under the 10-year clause of the act of February 20, 1905.

"This contention meets my approval. The underlying principle in the Singer-June Case is that it is against the policy of the law to extend the monopoly of the patentee or his successor in title in the patented article after the expiration of the patent through a name, which during the existence of the patent has become descriptive of the article.

"Then again, in construing the Trade-Mark Act of 1905, it is a reasonable inference that Congress did not intend that the provisions of that act should operate to continue the monopoly through registration under it, or that the use of a word in connection with a patented article and during the life of the patent should be availed of to make up the ten years of actual and exclusive use necessary to authorize registration."

See also *Centaur Co. vs. Heinsfurter et al.*, 84 F. 955; *Brill vs. Singer Mfg. Co.*, 41 Ohio State; *G. & C. Merriam Co. vs. Saalfeld*, 198 F. 369; *Yale & Towne Mfg. Co. vs. Restein et al.*, 196 F. 176; *Yale & Towne Mfg. Co. vs. Worcester Mfg. Co.*, 195 F. 528; *Marshall Engine Co. vs. New Marshall Engine Co.*, 89 U. E. 548; *Avenarius vs. Korenely*, 121 N. W. 336; *Rice-Stix Dry Goods Co. vs. J. A. Scriven Co.*, 165 F. 639; *Frank W. Witcher Co. vs. Sneierson*, 205 F. 767; *Hughes et al vs. Alfred H. Smith Co.*, 205 F. 303, 209 F. 37; *Yale & Towne Mfg. Co. vs. Worcester Mfg. Co.*, 205 F. 952; *Jenkins Bros. vs. Kelly & Jones Co.*, 212 F. 328; *Nathan Mfg. Co. vs. H. A. Rogers Co.*, 114 N. Y. S. 1033.

## VIII.

### Priority of Adoption and Use

In general, it can be stated that as between parties claiming the exclusive right to the same trade-mark, or marks substantially similar, the party proving priority of adoption and use is entitled to exclusive ownership, provided that the trade-mark in controversy had never been abandoned by the first user, or that the defense of laches or misrepresentation is not proven by the later user.

In *Metcalf vs. Hanover Star Milling Co.*, 204 F. 211, the Court of Appeals of the Fifth Circuit said:

"To invoke the jurisdiction of a court of equity to prevent infringement and unfair competition by the use of a similar trade-mark by another, it is incumbent upon the complainant to show that he has the property right in the mark or thing which indicates the ownership or origin of the article, and that its use has been fraudulently invaded by another. *Columbia Mill Co. vs. Alcorn*, 150 U. S. 460, *Epperson & Co. vs. Blumenthal*, 149 Ala. 125. The property right in a trade-mark is acquired chiefly, as we shall see, by prior adoption and exclusive use of the mark or symbol relied upon to distinguish the proprietor's ownership. The exclusive right to the use of a trade-mark rests, not so much on priority of invention, but upon such use as to indicate the origin

of plaintiff's goods, and must be early and separate enough for that purpose. Where long use is clearly shown, the mere fact that the owner has permitted the limited use by another, if such use was not calculated to mislead, will not defeat the owner's right to protection. . . .

"It appears to be well settled by authority that the first use of a trade-mark gives to the prior user the exclusive right to its use in trade to a commodity to which it is applied."

In *Layton Pure Food Co. vs. Church & Dwight Co.*, 182 F. 24, the Court said:

"The right to the exclusive use of a trade-mark is not gained or lost by claim or by registration. It is acquired by adoption and by a use so persistent and continuous that it comes to distinguish in the eyes and thought of purchasers and of those who seek to purchase the goods of its owner from those of other makers and sellers. When it has been thus acquired it may be lost by a failure to continue its use, by conveyance, or by renunciation. It is not dependent upon the national statute which authorizes the registration of trade-marks. It is a right secured under and protected by the common law."

In *Dietz et al. vs. Horton Mfg. Co.*, 170 F. 865 it was decided: That neither the complainant nor the defendant was entitled to the exclusive use of the word "Globe" as a trade-mark for washing machines, it appearing that this mark had been used by another manufacturer and his successors in business, whose machines had been sold throughout the country, for some years before the adoption of the mark by either of the parties to this action, and that such use continued for some years afterward.

In *New York Herald Co. vs. Star Co.*, 146 F. 204, it was held that the plaintiff was entitled to protection in the trade-mark "Buster Brown" as the title of a comic section of a newspaper, it having been shown that it was the first to use the title and that the name was used exclusively by the complainant and its licensees for such a length of time as to give it a proprietary right therein.

In *Thomas G. Carroll & Son Co. vs. McIlvaine & Baldwin, Inc.*, 171 F. 125, the Court said:

"The complainant gives undue weight to the series of registrations above set forth. Property right in a trade-mark exists in common law and is independent of the statutes regulating registration. Under the present Trade-Mark Act a certificate of registration is prima facie evidence of ownership; but this evidence may be contradicted in court and the apparent right of the registering party shown not to exist. Registration cannot confer a title to a trade-mark if some other individual has acquired a prior right by adoption and use; nor can it vest a title in the registrant as against another's common law title."

See also *W. A. Gaines & Co. vs. Rock Spring Distilling Company*, 179 F. 544; *Ohio Baking Powder Company vs. National Biscuit Company*, 127 F. 116; *Dodge Mfg. Co. vs. Sewall & Day Cordage Co.*, 142 F. 288; and *E. T. Fraim Lock Co. vs. Shimer* 43 Pa. Super. Ct. 221; *Spiegel vs. Zuckerman*, 175 F. 978; *R. Guastavino Co. vs. Comerma*, 180 F. 920; *Albers Bros. Milling Co. vs. Acme Mills Co.*, 171 F. 989; *Duluth Superior Milling Co. vs. Kofer*, 37 App. D. C. 115; *Sears & Nichols Co. vs. Brakeley*, 38 App. D. C. 530; and *H. Becker & Co. vs. C. A. Gambrill Mfg. Co.*, 38 App. D. C. 535; *Deitsch et al vs. Gibson*, 198 F. 410; *Richter vs. Reynolds*, 59 F. 577; *Case Bros. vs. E. W. Murphey & Co.*, 31 App. D. C.



245; J. R. Watkins Medical Co. *vs.* Sands et al, 86 N. W. 340; Eagle White Lead Co. *vs.* Pflugh et al, 180 F. 579; Avenarius *vs.* Kornely, 121 N. W. 333; Ill. Match Co. *vs.* Broomall, 34 App. D. C. 427; Crescent Oil Co. *vs.* W. C. Robinson & Sons Co., 34 App. D.C. 440; Galena-Signal Oil Co. *vs.* W. P. Fuller & Co., 142 F. 1002.

## IX.

## The Ten-Year Clause

The Ten-Year Clause of the Trade-Mark Laws of the United States is that provision of the Act of February 20th, 1905, which permits the registration of "*any mark* used by the applicant or his predecessors, or by those from whom title to the mark is derived in commerce with foreign nations, or among the several states, or with Indian tribes, which was in *actual and exclusive use* as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February 20th, 1905."

In Thaddeus Davids Co. *vs.* Cortland I. Davids, et al, decided by the United States Supreme Court, April 27, 1914, it was held that:

1. The ten-year clause of the trade-mark act of 1905, has manifest reference to marks which are not technical trade-marks, and is intended to bring within the statute marks that have acquired a secondary significance by reason of ten years' actual and exclusive use.

2. This clause modifies the preceding prohibition of the statute against the registration of proper names, descriptive and geographical terms, and makes such marks eligible to registration when the conditions as to use are fulfilled.

3. A proper name registered under the ten-year clause becomes a trade-mark and is entitled to protection commensurate with that accorded to any other mark registered under the statute.

4. The protection extended to a mark registered under the ten-year clause of the act is not confined to the prevention of the use thereof in the precise manner employed by the registrant, but extends to any case of colorable imitation.

5. A proper name, though registered as a trade-mark under the ten-year clause of the trade-mark act, can not be exclusively appropriated, but is to be protected against any use thereof by another in a manner calculated to deceive.

In Coca-Cola Co. *vs.* Nashville Syrup Co., 200 Fed. 157, it was held, that the Act of Congress of February 20, 1905, providing for the registration of trade-marks used by an applicant and his predecessors in interstate commerce for ten years prior



to the passage of the Act, necessarily implied that a trade-mark when so registered should constitute a mark as defined by Section 29, and therefore the complainant having used the word or words "Coca-Cola" as a trade-mark in interstate commerce for more than ten years prior to the passage of such Act and duly caused the same to be registered, such mark was not limited to the script in which the words "Coca-Cola" were written in connection with complainant's product either in the hyphenated or unhyphenated, but extended to the use of the words themselves in the sale of a similar article, and that the complainant having registered such a mark had obtained the exclusive right to the use of the same as a statutory trade-mark.

In *American Lead Pencil Co. vs. L. Gottlieb & Sons*, 181 F. 178, the Court held that where the complainant had used the trade-mark "Beats-All," associated with lead pencils since 1888, and had used the same in interstate commerce prior to April 1, 1895, and on April 17, 1906, had obtained registration of the trade-mark in the United States Patent Office, such registration imparted to the words, which originally were only descriptive and not subject of a valid trade-mark, a secondary meaning indicating goods exclusively manufactured by the complainant, which made the words available as a proper and technical trade-mark.

*Cohn Belt & Co.*, 27 App. D.C. 173; *Commonwealth vs. Sherman Mfg. Co.*, 75 N. E. 71; *Worcester Brewing Corp. vs. Rueter & Co.*, 30 App. D.C. 428; *Thaddeus Davids Co. vs. David's et al*, 178 F. 801, 192 F. 915; *Coca-Cola Co. vs. Deacon Brown Bottling Co. et al*, 200 F. 105; *N. Y. Mackintosh Co. vs. Flam*, 198 F. 571; *Warner Bros. Co. vs. David Wiener*, Apr. 28th, 1914; *Rossmann vs. Garnier*, 211 F. 401.

## X.

### Loss of Trade-Mark Rights

Trade-mark rights may be lost through abandonment, laches, acquiescence, misrepresentation or fraud, and any one of these causes may be interposed as a defense to an action for infringement.

#### Abandonment:

The question of intent on the part of the owner of a trade-mark determines whether the trade-mark has been abandoned or not, although sometimes an intent to abandon will be inferred.

In *Saclehner vs. Eisner & Mendelsohn Co.*, 179 U. S. 19-31-1900, the Court, speaking by Mr. Justice Brown, said:

"To establish the defense of abandonment, it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon. Acts which, unexplained, would be sufficient to establish an abandonment, may be answered by showing that there never was an intention to give up and relinquish the right claimed."

In *Metcalf vs. Hanover Star Milling Co.*, 204 F. 211, the Circuit Court of Appeals, Fifth Circuit, said:

"Abandonment, as we have seen, must be supported by a clear intention of the owner to discontinue the use of the trade-mark. The evidence does not show any purpose on the part of defendant to abandon the use of the Tea Rose in the territory generally occupied in its trade."

In *Actiengesellschaft Vereinigte Ultramarin-Fabriken vs. Amberg*, 109 F. 151, the Court held that the fact that others than the complainant had used a certain style of dressing for their goods, which the latter originated and used continuously for many years was not sufficient to establish an abandonment of its right to the exclusive use thereof unless it appeared that by its acquiescence in such use there was indicated not only a practical abandonment, but an actual intent to abandon.

In *Burt et al, vs. Tucker*, 59 N. E. 1111, the defendant had used the word "Knickerbocker" for two years to indicate shoes manufactured by him, but discontinued to use the trade-mark for four years on going out of business. On the reestablishment of his business in another state, he named his concern the "Knickerbocker Shoe Company." Plaintiff, during the time of defendant's non-use of the name, used the same, and brought suit to restrain defendant's use of the trade-mark, in which proceeding the defendant testified that he had not intended to abandon the use of the mark. Held, sufficient to support a finding that defendant had not abandoned the trade-mark.

In *Edward & John Burke, Ltd., vs. Bishop*, 175 F. 167, the Court held that in order to establish abandonment of a merchant's right to protect his labels and dress of goods in association with which his merchandise was sold, an actual intent to abandon had to be shown, though it might be inferred from his acts or laches necessarily pointing to actual abandonment.

In *McGraw Tire & Rubber Co. vs. Griffith et al*, 198 F. 566, the Court said:

"If defendant 'could be supposed to have any prior rights in 'the word Imperial' I think they abandoned it' by a contract with complainant under which they bought 7,500 tires, all of which were marked by complainant with this mark to which defendant made no protest except a suggestion that complainant should either sell all of its tires to defendant or else use another brand for a trade-mark which was never followed up."

See also *Michigan Condensed Milk Co. vs. Kenneweg Co.*, 30 App. Cases (D.C.) 491; *Deitsch vs. George R. Gibson Co.*, 155 F. 383; *Eiseman vs. Schiffer*, 157 F. 473; *Raymond vs. Royal Baking-Powder Co.*, 85 F. 231; *In re John Broadland*, 37 App. D.C. 602; and *Star Brewery Co., vs. Val. Blatz Brewing Co.*, 36 App. D.C. 534; *Blackwell & Co. vs. Dihrell & Co.*, 3 Hughes, 151; *Celluloid Mfg. Co. vs. Cellonite Mfg. Co.*, 32 F. 94; *Nolan Bros. Shoe Co. vs. Nolan*, 131 Cal. 271; *Dr. Dadirrian & Sons Co. vs. Hanenstein*, 74 N.Y.S. 709; *Baglin vs. Cusenier Co.*, 156 F. 1015; *Anenarius vs. Kornely*, 121 N.W. 336; *Nelson vs. J. H. Winchell Co.*, 89 N.E. 180; *Edward & John Burke, Ltd. vs. Bishop*, 175 F. 167; *Layton Pure Food Co. vs. Church & Dwight Co.*, 182 F. 24; *Water Proofing Co. vs. Hydrolithia Cement Co.*, 138 N.Y.S. 265.

**Laches :**

Laches differ from abandonment in that the element of intention is absent, and may be divided into two classes: (1) mere delay in bringing suit; (2) where there has been such acquiescence as to make the relief asked for inequitable to others having intervening rights.

(1) In *Cahn vs. Gottschalk*, 2 N. Y. Supp. 13, it was held that five years' delay in bringing suit, after notice of the acts constituting unfair competition, would bar an action for the recovery of profits, though not the granting of an injunction.

In *Dr. Peter H. Fahrney & Sons Co. vs. Ruminer*, 153 F. 735, the complainant notified the defendant to desist from the use of a trade-name which was alleged to constitute unfair competition, and the defendant refused. Complainant then waited four years before proceeding legally against the defendant, and it was held that whatever effect such delay might have upon the right to damage, it did not preclude the complainant from injunctive relief.

In *Eagle White Lead Co. vs. Pflugh*, 180 F. 579, the complainant in 1893 advised defendants of its right to a trade-mark which it claimed the defendants were infringing, but the complainant did not follow up the letter with legal proceedings, until 1910.

The Court said:

"As early as 1893 the defendants were advised by letter (dated February 1, 1893) of complainant's asserted rights in such trade-mark. The failure of complainant to follow up this letter with legal proceedings in my judgment disentitles it to an accounting for past profits, but it is not sufficient to forfeit its right to protection against future infringement. . . . The neglect of complainant, however, to bring suit for such a length of time must be considered as a waiver of damages. By its delay in proceeding against defendants they were encouraged in their insistence that their trade-mark did not infringe complainant's mark, and to a continued use of it in building up their trade. Such delay on complainant's part was tantamount to a license, and while revocable at will, should be treated in equity as a waiver of the profits that have inured before bringing suit."

See also *Consolidated Ice Co. vs. Hygeia Distilled Water Co.* 151 F. 10; *Virginia Hot Springs Co. vs. Hegeman & Co.*, 144 F. 1023; *Edward & John Burke, Limited vs. Bishop*, 175 F. 167; and *Eagle White Lead Co. vs. Pfluger*, 180 F. 579; *Salvation Army in the U. S. vs. American Salvation Army*, 114 N.Y.S. 1039; *Layton Pure Food Co. vs. Church & Dwight Co.*, 182 F. 24; *Nelson vs. Winchell & Co.*, 89 N.E. 180.

(2) In *Dietz vs. Horton Mfg. Co.*, 170 F. 865, the owner of a trade-mark had permitted other manufacturers to use the mark for a number of years without objection, and it was held that the mark became so far common property that the only restriction which could be imposed upon its use was that each owner

should identify his goods so as to indicate their origin, and prevent confusion, deception and unfair competition.

See also *American Tobacco Co. vs. Polacsek*, 170 F. 117; *Swain vs. Seamans*, 76 U.S. 254; *French Republic vs. Saratoga Vichy Spring Co.*, 191 U.S. 427; and *Saxlehner vs. Nielsen*, 179 U.S. 43.

### Misrepresentation and Fraud:

Material misrepresentation constituting a fraud on the public is obnoxious to a Court of Equity and no relief will be given to one guilty of such misrepresentation.

In *Memphis Keeley Institute vs. Leslie E. Keeley Co.*, 155 F. 964, the complainant was a manufacturer and proprietor of a secret remedy which it sold and used for the treatment and cure of opium, liquor and tobacco habits, and which it claimed and represented to the public as having as its chief and most valuable ingredient "Chloride of Gold" or "Double Chloride of Gold." The analysis showed that the complainant made false and fraudulent representations as to the ingredients of this remedy through its advertisements and labels. The Court held that the complainant had made fraudulent representations, as the remedy did not contain any "Gold" or "Chloride of Gold" and had therefore come into court with "unclean hands," no relief could be afforded and the bill of complaint should be dismissed.

In *California Fig Syrup Company vs. Frederick Stearns & Co.*, 73 F. 812, suit was brought by a manufacturer of a laxative medicine, to which he gave the name "Syrup of Figs" or "Fig Syrup," to enjoin another from interfering with his business by unfair competition. It was held that complainant was not entitled to an injunction because it falsely represented to the public that the juice of the fig was the important medicinal agent in the composition of the medicine, when in fact just a suspicion of fig juice was put into it, not for the purpose of affecting its medicinal character, or even its flavor, but merely to give a weak support to the statement that the article sold was "Syrup of Figs" while the laxative agent in it was Senna. This was so held notwithstanding that there was much evidence introduced showing that it was a very useful medicine and prescribed by physicians of high standing.

Judge Taft said:

"This is a fraud upon the public. It is true that it may be a harmless humbug to palm off on the public as Syrup of Figs what is Syrup of Senna, but it is nevertheless of such a character that a Court of Equity will not encourage it by extending any relief to

the person who seeks to protect a business which is most different and is dependent upon such deceit."

This case was subsequently approved and followed by the Supreme Court in the case of *Worden vs. California Fig Syrup Company*, 187, U.S. 519.

In *Hazlett vs. Pollack Stogie Co. et al*, 188 F. 494, affirmed 195 F. 28, the decedent during his lifetime had built up a large and profitable business in stogies, which were sold under his name and became known as "Pollack's Stogies"; the word "Pollack" alone becoming generally connected with cigars made by him. Among other distinctive marks used on his packages was a guaranty signed in script over his reproduced signature and the factory certificate which also stated that decedent was the manufacturer, and on the front of his factory, was decedent's name as manufacturer, which name constituted his principal trade-mark. Two years after his death, complainant, who succeeded him, sent out a letter to the trade printed in script and purported to be signed by decedent, calling attention to the development of the business and soliciting continued favorable consideration; the business being continued by complainant as agent of decedent's widow and children. Held, that complainant's continuance of the use of decedent's trade-mark and dress of package, without anything to show that the goods were no longer made under the personal supervision of decedent, tended to mislead the public, and therefore precluded him from maintaining a bill for infringement.

The Court said:

"In view of these facts can the present bill be maintained by the complainant? Without imputing to complainant any bad faith or intent to deceive the public, we are of the opinion that under the facts stated the law forbids the maintenance of his bill. One of the essentials of an enforceable trade-mark right is that the goods it represents shall in no way mislead the public. When a manufacturer has by his personality, skill or character built up a reputation or good-will for his goods, which goods have a higher value than those of other makers, it is quite clear that he cannot transfer to others the right to affix his name to those goods when he has ceased to manufacture them, and his transferee mislead the public into the belief that the skill and character which gave the product distinctive merit still continue to do so. Under such circumstances fairness to the public demands that he who succeeds to the manufacture of a product of earned personal repute must in some appropriate manner apprise the public of the changed condition."

In *Bear Lithia Springs Co. vs. Great Bear Springs Co.*, 71 Atl. 383, the Court held that complainant's advertisement of its water as "bottled at the spring" when in fact it was bottled at a city warehouse, and also the declaration in such advertisement that such water was a cure for certain diseases named therein, contrary to the truth, were such misrepresentations as would induce the court to refuse complainant any relief.

See also *Prince Manufacturing Company vs. Princess Metallic Paint Company*, 135 N.Y. 24; *Leach vs. Scarft*, 188 F. 446; *Hazlett vs. Pollack Stogie Co.*, 188 F. 494; *James Van Dyk Co. vs. F. V. Reilly Co.*, 130 N.Y. Supp. 755; and *Burrow vs. Marceau*, 124 N.Y.



Supp. 810; *Manhattan Medicine Co. vs. Wood*, 108 U.S. 218; *De Nobili vs. Scanda*, 198 F. 341; *Clotworthy vs. Schepp*, 42 F. 62; *Kohler Mfg. Co. vs. Beeshore*, 59 F. 572; *Moxie Nerve Food Co. of New England vs. Modox*, 152 F. 493; *Fray, et al. vs. Lambourne, et al*, 124 App. Div. (N. Y.) 245; *Beecham vs. Jacobs*, 159 F. 129; *Koehler vs. Sanders*, 122 N.Y. 65.

## XI.

### Assignability of Trade-Marks

A trade-mark cannot be assigned or its use licensed, except as an incident to a transfer of the business or property in connection with which it has been used.

Section 10 of the Trade-Mark Laws of the United States reads as follows:

"That every registered trade-mark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good-will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The commissioner shall keep a record of such assignments."

In *Dietz vs. Horton*, 170 F. 865, it was held that a trade-mark cannot be assigned, except as incident to the sale of the business and good-will in connection with which it has been used, or as an incident to the sale of the premises where the article has been made and has acquired a special reputation in connection with such place.

In *Bulte vs. Igleheart Bros.*, 137 F. 492, the Court said:

"A trade-mark is analogous to the good-will of a business. Whoever heard of a good-will being sold to one, while the original owner continues the business as before? The good-will is inseparable from the business itself. So likewise is a trade-mark or a trade-name that gives assurance to a purchaser that the article upon which is stamped the trade-mark or trade-name is the genuine production of the manufacturer to whom the trade-name or trade-mark points by association as the maker of the article. Therefore it is, that it is a necessary qualification to the assignability of a trade-mark that there goes with it the transfer of the business and good-will of the owner of the symbol."

In *Morgan et al. vs. Rogers*, 19 Fed. 596, it was held that as an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public, but in connection with the article produced it may be bought and sold like other property.

In *Independent Baking Powder Co. vs. Boorman*, 175 F. 448 it was held that a manufacturer cannot make a valid assignment of a trade-mark separate from a transfer of the good-will and business in connection with which it was used.

In *Hoffman vs. B. Kuppenheimer & Co.*, 183 F. 597, it was held that a patentee, who has adopted and registered a trade-mark, which he uses to designate the patented article, may assign the right to use such trade-mark as an incident to a license to make and sell the patented article, without losing his rights therein, and, on the termination of the license, he is re-invested with full title to the trade-mark, with the right to protection against its continued use by the licensee.

In *Manhattan Medicine Co. vs. Wood*, 108 U. S. 223, the Court said:

"The object of the trade-mark being to indicate, by its meaning or association, the origin or ownership of the article, it would seem that when a right to its use is transferred to others, either by act of the original manufacturer or by operation of law, the fact of transfer should be stated in connection with its use; otherwise a deception would be practiced upon the public and the very fraud accomplished, to prevent which courts of equity interfere to protect the exclusive right of the original manufacturer. If one affix, to goods of his own manufacture, signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers."

See also *Spiegel vs. Zuckerman*, 175 F. 978; *MacMahan Pharmaceutical Co. vs. Denver Chemical Manufacturing Company*, 113 F. 468; *Independent Baking Powder Company vs. Boorman*, 175 F. 448; *Jackson Corset Co. vs. Cohen*, 38 App. D.C. 482; *Ludwig & Co. vs. Claviola Co.*, 144 App. Div. (N.Y.) 388; and *Burrow vs. Marceau*, 124 N.Y. Supp. 810; *Kidd vs. Johnson*, 100 U.S. 617; *Morgan et al vs. Rogers*, 19 F. 596; *The Atlantic Milling Co. vs. Robinson*, 20 F. 217; *Richmond Nervins Co. vs. Richmond*, 159 U.S. 293; *Hoffman vs. B. Kuppenheimer & Co.*, 183 F. 597.

## XII.

### Knowledge or Intent

It is no defense to an action for trade-mark infringement that the defendant had no knowledge of the plaintiff's mark when he commenced to use the infringing trade-mark, or that he acted without any intent to infringe upon the rights of the plaintiff.

In *Eagle White Lead Co. vs. Pflugh*, 180 F. 579, the Court said:

"The question of infringement is to be determined by the test of dominancy. The dissimilarity in size, form and color of the label and the place where applied are not conclusive. If the competing label contains the trade-mark of another and confusion or deception is likely to result, infringement takes place, regardless of the fact that the accessories are dissimilar. Duplication or exact imitation is not necessary; nor is it necessary that the infringing label should

suggest an effort to imitate. The appropriation of the symbol may be without knowledge that another has obtained the right to its exclusive use. . . . The method and accompaniments of its use may negative the idea of imitation and yet infringement exist."

In *Lawrence Mfg. Co. vs. Tennessee Mfg. Co.*, 138 U. S. 537, the Court held that in the case of a technical trade-mark, where infringement is clearly shown, fraudulent intent will be inferred.

In *Reading Stove Works, Orr, Painter & Co. vs. S. M. Howes Co.*, 87 N. E. 751, it was held that to restrain a manufacturer from making and selling goods under the trade-mark of another, it was not necessary to prove that customers have actually been deceived and have bought such goods under the belief that they were made by the owner of the trade-mark; but it was sufficient if the resemblance is likely, upon comparison, to cause one to be mistaken for the other, and it is not material that dealers or customers were indifferent whether the goods were those made by the owner of the trade-mark or those made by the infringer, as it was the attempt to dispose of goods by misrepresentation that constituted the wrong.

See also *Foster Mfg. Co. vs. Tower Co.*, 97 N. E. 749; *Stephano vs. Satimatopoulos*, 199 F. 451; *Lawrence Mfg. Co. vs. Tennessee Mfg. Co.*, 138 U.S. 537; *McLean vs. Fleming*, 96 U.S. 245; *Welsbach Light Co. vs. Adam et al*, 107 F. 463, N. K. Fairbank Co. vs. Luckel, King & Cake Soap Co., 102 F. 327; *W. A. Gaines Co. vs. Turner-Looker Co.*, 204 F. 553; *De Voe Snuff Co. vs. Wolff*, 206 F. 420.

### XIII.

## Infringement of Marks, Symbols, Devices and Names

The law relative to the infringement of marks, devices, symbols and names is perhaps best shown by a brief summary of some of the cases on this subject.

In *Victor Talking Machine Co. vs. Bradley*, 171 F. 951, the complainant used a red seal or label in the center of its talking machine discs or records bearing its trade-mark. The court held that the use by the defendant of a red band around the labels of its records did not constitute an infringement of the complainant's trade-mark, especially where the records of the defendant in no other respects resembled those of the complainant.

In *Walter Baker & Co., Ltd. vs. Delapenha et al*, 160 F. 746, the complainants registered as trade-marks the word "Auto" and a picture of a motor car, to be used on packages of chocolate. The court held that these marks were infringed by the defendants through the latter's use of both the word "Auto" and the picture of an automobile on packages of imported chocolate although these packages were somewhat different in style and coloring

from those of the complainant, and the defendant had registered the design in Switzerland prior to its use in this country by the complainant, the defendant not having used the design in the United States until after its use by the complainant.

In *Holeproof Hosiery Co. vs. Wallach Bros.*, 190 F. 606, it was held that the word "Holeproof" as a trade-mark for hosiery was not invalid as descriptive where it had been used and advertised for such a length of time as to have acquired a secondary meaning as designating the product of a particular maker. The complainant had made and sold hosiery under the trade-mark "Holeproof" and when sold by the box gave a guarantee of replacement if holes appeared in the hosiery within six months, which fact was novel and was widely advertised. The defendant, who as a dealer had been selling the complainant's product, became agent for a different make, sold under the name of "Knotair," which it had put up in boxes closely resembling those used by the complainant, and advertised and sold the same with a similar guarantee as the complainant, and to customers who called for "Holeproof," although not actually representing it as such.

The court held that: "Knotair" as applied to a make of hosiery, was an arbitrary name and in itself did not constitute an infringement of the trade-mark "Holeproof." But inasmuch as defendant by its acts had evidenced an intention to obtain an advantage from the advertising and popularity of complainant's goods, it so acted as to constitute unfair competition and it would be and was enjoined.

In *Reymer & Bros., Inc. vs. Huyler's*, 190 F. 83, it was held that the word "Metropolitan" when used by a manufacturer on pound and half-pound boxes of chocolates was an arbitrary and fanciful word, and constituted a valid trade-mark, which was infringed by its use by another, although employed in connection with other words in the sale of chocolate cakes at candy stores in the same city and vicinity where the trade-mark had become identified by long use with the goods of the first user.

As bearing on this point, the Court said:

"Complainant's trade-mark then being a valid trade-mark, and one to the exclusive use of which, as used by the complainant, it is entitled, it only remains to determine whether or not respondents have infringed. It clearly appears, by a comparison of the packages used by complainant and respondents, that the words 'Metropolitan,' 'Chocolate,' or 'Chocolates' are conspicuously presented. The different shape of the package is not likely to be observed by the ordinary purchaser because the class of goods being dealt in, candies and chocolates, are placed in many different kinds of packages by the same manufacturer. The ordinary person having in mind chocolate which is ready for consumption and 'Metropolitan' as descriptive of Reymer's chocolate, is unlikely to look further than for the two words. These he finds on both packages. As said in *Celluloid Manufacturing Company vs. Cellonite Manufacturing Company*, 32 F. 94: 'Similarity, not identity, is the usual recourse when one party seeks to benefit himself by the good name of another.'"



In *Hartzler et al, vs. Goshen Churn & Ladder Co.*, 104 N. E. 34, the plaintiff had used the name "Security" as a trade-mark for ladders of its manufacture, and it was held that it was entitled to an injunction to prevent the defendant from using the corporate name "Security Ladder Company."

In *Charles E. Hires Co. vs. Xepapas*, 180 F. 952, the complainant manufactured two preparations for making root beer. One was in syrup form, to be prepared as a beverage by the addition of carbonated water, and the other was an extract intended to be prepared as a beverage by the addition of sugar and water and fermented with yeast. Complainant had extensively advertised its fountain syrup preparation, and the beverage prepared therefrom was called by consumers "Hires" or "Hires Root Beer." Defendant purchased the extract, and made a beverage therefrom by the addition of simple syrup and carbonated water, without following the directions to prepare it by fermentation with yeast, and sold the beverage as "Hires" or "Hires Root Beer." Held, that defendant's action constituted a violation of complainant's trade-name rights in the name "Hires."

In *De Voe Snuff Co. vs. Wolff*, 206 F. 420, the plaintiff and its predecessors in business had for more than seventy years been continuously engaged in the manufacture of snuff, which was widely advertised and sold throughout the United States. During that time its mills had been known as the Eagle Mills, and it and its predecessors had used on their packages and stationery the picture of an eagle, together with the words "Eagle Mills" or "Eagle Snuff," so that its product had been long known to the trade and to purchasers in general as "Eagle Snuff." The Court held that the plaintiff had a common law trade-mark in the picture of an eagle and the word "Eagle" as applied to snuff, whether used in association with any other words or not, and that the use by the defendant on its packages of snuff of the picture of an eagle and the name "White Eagle Snuff" was an infringement, although both picture and name differed materially from those used by the plaintiff. The court further held that it was not necessary to constitute infringement; that every element of a trade-mark should be appropriated, nor that it should be completely copied, the proper test being whether when taking the resemblances and differences into account, the former was so marked that the ordinary purchaser would be likely to be deceived thereby. The Court of Appeals said:

"It is doubtless true that the dealer accustomed to handling plaintiff's snuff would be not deceived by the plaintiff's labels or advertising matter. But this is not, we think, true of the ultimate purchaser, if, as we have found to be the fact, the name 'Eagle Snuff' has come to be associated in the minds of the public with, and to represent, plaintiff's product. We think it clear that the ordinary purchaser accustomed to buy and use the plaintiff's snuff and not seeing the respective products side by side, could readily be deceived into purchasing defendant's product as that of the complainant, presenting as the former does the idea of Eagle Snuff



as a permanent character. It may be true that the cautious and discriminating purchaser is not likely to be so misled; but protection accorded to a trade-mark is not limited to the cautious and discriminating customer, but embraces the 'ordinary' or 'unwary' purchaser as well."

In *Taendticksfabriks Aktiebolaget Vulcan vs. Myers*, 139 N. Y. 364, the Court of Appeals of the State of New York said

"No evidence has been given or offered to show that any person had actually been deceived by the imitation of complainant's trade-mark, and we think that none was necessary for the maintenance of the action. It is the liability to deception which the remedy may be invoked to prevent. It is sufficient if injury to the complainant's business is threatened or imminent, to authorize the Court to intervene to prevent its occurrence. The owner is not required to wait until the wrongful use of his trade-mark has been continued for such a length of time as to cause some substantial pecuniary loss."

See also *Benjamin Moore & Co. vs. Auwell*, 178 F. 543; *Northwestern Consolidated Milling Company vs. Mauser & Cressman*, 162 F. 1004; *Chalmers Knitting Company vs. Columbia Mesh Knitting Co.*, 160 F. 1013; *Eureka Fire Hose Co. vs. Eureka Rubber Mfg. Co.* 60 A. 561.

#### XIV.

### Defense that Complainant and Defendant Are Not Competitors

It is a good defense to a suit for infringement that complainant and defendant do not trade in the same lines of merchandise and therefore are not competitors. The difference, however, must be a decided one to allow the defendant to avail himself of this defense.

In *Elgin National Watch Co. vs. Loveland*, 132 F. 41, the Court said:

"It is urged that the business of the defendants as conducted by them is not in competition with that of the complainant; that complainant manufactures watch movements only; that defendants do not manufacture watch movements, but confine their business to the sale of watches upon mail orders only, and articles of jewelry, silverware and other goods of a cheap class, in which complainant does not deal, and therefore no injury results or can result to it. It is true that complainant could not complain of the use of the word "Elgin" by a manufacturer or vendor of some product not of the same general line as the complainant. Such a business would not be in competition with it." From the evidence produced, however, the Court decided that unfair competition existed.

See also *American Tobacco Co. vs. Polacsek*, 170 F. 117; *Charles E. Hires Company vs. Xepapas*, 180 F. 952; *McGraw Tire & Rubber Co. vs. Griffith*, 198 F. 566; and *G. Heileman Brewing Co. vs. Independent Brewing Co.*, 191 F. 489.

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## PART II.

# UNFAIR COMPETITION

### I.

## Definition

Unfair competition is competition consisting in the conduct of a trade or business in such a manner that there is either an expressed or implied representation that the goods or business of one man are the goods and business of another.

"It is the duty of a subsequent trader coming into an established trade not to dress up his goods or market them in such a way as to cause confusion between his goods or business and that of a prior trader. Even conceding that the later trader has an equal abstract right to use particular words, names or marks, yet if his unexplained use of them will cause confusion and deception, he must accompany such use with affirmative distinguishing features sufficient to render deception improbable. This rule applies to all classes of names, including descriptive, generic, personal and geographical names, which, although primarily *publici juris*, have acquired a secondary meaning and come to indicate the source of particular articles, the mere use of such a name by another, unaccompanied by adequate distinguishing statements, in itself amounts to an artifice calculated and intended to deceive, and constitutes unfair competition.

"It is a question of fact in each case whether or not the goods or business of the subsequent trader have been so distinguished as to prevent any actual or probable confusion and deception. All the circumstances of the particular case must be considered. It is presumed that the public uses its senses and takes note of differences which are thus disclosed. But on the other hand it must be remembered that similarity, not identity, is the usual recourse when one party seeks to benefit himself by the good name of another so that the mere existence of differences does not necessarily show honest and sufficient differentiation. A nice discrimination is not to be expected from the ordinary purchaser. Although differences between their respective labels and packages exist, and are readily apparent upon comparison, yet if the ordinary purchaser is liable to be deceived by the similarities which also exist, an injunction will be granted. Where the distinctive part of a name or mark is taken, minor differences afford no defense. Similarity in the main distinguishing features will usually be sufficient to constitute infringement or unfair competition."

38 Cyc. 789-90-91, cited in *Safe-Cabinet Co. vs. Globe-Wernicke Co.*, Ohio Ct. of Appeals decided Jan. 31, 1914.

In *Coats et al vs. Merrick Thread Co. et al.*, 149 U. S. 562 the Court said:

"The controversy between the two parties then is reduced to the single question whether, comparing the two designs upon the main or upper end of the spool, there is such resemblance as to indicate an intent on the part of defendants to put off their thread upon the public as that of the plaintiffs, and thus to trade upon their reputation. There can be no question of the soundness of

the plaintiffs' proposition that, irrespective of the technical question of trade-mark, the defendants have no right to dress their goods up in such manner as to deceive an intending purchaser, and induce him to believe he is buying those of the plaintiffs. Rival manufacturers may lawfully compete for the patronage of the public in the quality and price of their goods, in the beauty and tastefulness of their enclosing packages, in the extent of their advertising, and in the employment of agents, but they have no right, by imitative devices, to beguile the public into buying their wares under the impression they are buying those of their rivals."

In *Sayre et al vs. McGill Ticket Punch Co.*, 200 F. 771, the Court defined unfair competition as follows:

"Unfair competition is the passing off or attempting to pass off on the public the goods and business of one as being the goods and business of another."

See *Fuller vs. Huff*, 104 F. 141, 43 C.C.A. 453; *Keuffel & Esser Co. vs. H. S. Crocker Co.* 118 F. 187; *Drake Medicine Co. et al vs. Glessner*, 68 Ohio St. 337; *Dyment vs. Lewis*, 123 N.W. 244; *Forster Mfg. Co. vs. Cutter Tower Co.* 97 N.E. 749.

## II.

### Distinction Between Infringement and Unfair Competition

The distinction between infringement and unfair competition has been pointed out in numerous decisions.

In *G. W. Cole Co. vs. American Cement & Oil Company*, 130 F. 703, the Court said:

"An infringement of a trade-mark consists in the use of the genuine upon substituted goods or of an exact copy or reproduction of the genuine, or in the use of an imitation in which the difference is colorable only, and the resemblance avails to mislead so that the goods to which the spurious trade-mark is affixed are likely to be mistaken for the genuine product; and this upon the ground that the trade-mark adopted by one is the exclusive property of its proprietor, and such use of the genuine, or such imitation of it, is an invasion of his right and property. Unfair competition is distinguishable from the infringement of a trade-mark in this: That it does not necessarily involve the question of the exclusive right of another to the use of the name, symbol or device. A word may be purely generic or descriptive, and so not capable of becoming an arbitrary trade-mark, and yet there may be an unfair use of such word or symbol which will constitute unfair competition. Thus a proper or geographical name is not the subject of a trade-mark, but may be so used by another, unfairly producing confusion of goods, and so come under the condemnation of unfair trade, and its use will be enjoined. The right to the use of an arbitrary name or device as indicia of origin is protected upon the ground of a legal right to its use by the person appropriating it."

In *Metcalf vs. Hanover Star Milling Co.*, 204 F. 211, the Court said:

"Infringement is the wrongful copying and setting forth of an article well calculated to be taken for one already established in the trade, and is regarded in the law as analogous to trespass. Unfair competition consists in the placing on the established trade of another an article or commodity dressed so as to be very like the other and in palming off the imitation as the original."

In *Hanover Star Milling Co. vs. Allen & Wheeler Co.*, 208 F 518, the Circuit Court of Appeals, Seventh Circuit, the Court said as follows:

"In both the 'trade-mark' and the 'unfair competition' cases the ground of the action and the reason for the remedy are identical. They are all cases of unfair competition in trade, and the remedy is to tie the hands of the unfair trader. To the extent that differences exist, they pertain, not to the underlying principle, but to the methods and degrees of proof required to enforce the principle. If a dealer has adopted a true trade-mark, his trade has given the mark its only meaning, and he need produce no other proof respecting meaning. If he has applied to his article a mark or name that had an existing meaning, it is incumbent on him to establish the fact that his trade has added a new meaning that is exclusively appendant to his trade. If a defendant has put into a common market his articles bearing another dealer's technical trade-mark, no further proof of fraud is required. If a defendant has put into a common market his articles bearing a mark or name that had a common meaning, the complainant must show that the defendant is using the mark or name, not in its common meaning, but in its new meaning created by the complainant. In 'trade-mark' cases, it is sometimes said that proof of fraudulent intent need not be made. This is hardly accurate; the truth being that proof of knowing use carries proof of intent."

In *Pope Automatic Merchandising Co. et al vs. McCrum-Howell Co.*, 191 F. 979, it was held that the manufacturer of an unpatented mechanical implement, who had selected unpainted aluminum as the most suitable material and had adopted the most simple, efficient, and economical form of construction in which the combination could probably be embodied, with nothing for embellishment or distinction, except a name-plate, could not charge a competitor with unfair competition, because, for the same utilitarian reasons, he used the same construction in all respects, excepting as to the name-plate, which he made distinctive, no deception of purchasers being shown.

### III.

#### **Nature of Unfair Competition**

The following cases will give a fair idea of the nature of unfair competition and the right to protection against it:

In *Pillsbury-Washburn Flour Co. et al vs. Eagle* 86 F. 608, certain millers in Minneapolis, Minn., and their predecessors in business had, for over thirty years, made flour by the roller patent process and had used as brands the words "Minneapolis," "Minnesota" and "Minnesota Patent," etc. The words "Minnesota" or "Minnesota Patent" meant that the flour was made under the roller patent process somewhere in Minnesota, while the word "Minneapolis" signified to the trade that the flour was made at a Minneapolis flouring mill. The defendant, who was a dealer in Chicago, Ill., obtained from millers at Milwaukee, Wis., an inferior grade of flour which he

labeled "Best Minnesota Patent, Minneapolis, Minn.," and advertised his flour as made at Minneapolis, with the result that the public was deceived into buying his flour under the belief that it was made at Minneapolis, whereby the public was defrauded and the business of the Minneapolis millers damaged. The Court held that it was within their province to grant relief prohibiting the fraud and preventing the damage to the business of the Minneapolis millers.

In *Selchow et al vs. Chaffee & Selchow Mfg. Co.*, 132 F. 996, the complainant had introduced into this country thirty-five years prior to the commencement of this action a game, which was made and sold under the name of "Parcheesi." This name it registered in good faith as a trade-mark in the Patent Office. The defendant, a manufacturer, appropriated for its own use the name "Parcheesi" which had become known and popular through its use by the complainant, and also incorporated the complainant's name "Selchow" in its own corporate name without any apparent reason except to deceive the public as to the origin of the goods which it sold.

The Court said:

"A careful examination of all the evidence fails to disclose any reason for the use by the defendant of the word 'Parcheesi' as designating its goods, or of the name 'Selchow' in the corporate name, except to confuse the public, and enable it to gain the market and trade built up by the complainants. Defendant is clearly guilty of unfair competition in trade, and the complainants are entitled to a decree restraining the use by defendant of the word or name 'Parcheesi' and of the name 'Selchow' in the name of the firm, and also for an accounting."

In *Enterprise Manufacturing Co. vs. Landers, Frary & Clark*, 131 F. 240, the defendants admitted that they were manufacturing and selling coffee-grinding mills in competition with the mills of the complainant, and that they had used parts of the complainant's mills as patterns wherever it was convenient or profitable to do so, and that at the time the action was brought they were still making and selling mills which in effectiveness and attractiveness were equal to the goods sold by complainant. The Court held that such competition was unlawful and entitled the complainant to an injunction.

The Court said:

"No doubt with such identity in attractiveness, competition with complainant's mills would be more effective, but defendants overlooked the fact that courts of equity will not allow a man to palm off his goods as those of another, whether his misrepresentations are made by word of mouth, or more subtly by simulating the colocation of details of appearance by which the consuming public has come to recognize the product of his competitor."



In *Dennison Manufacturing Co. vs. Scharf Tag, Label & Box Company*, 135 F. 625, the Court held that a series of numbers used by a manufacturer of labels in its catalogues and in connection with its corporate name on the boxes containing its labels, not primarily to indicate origin, but to designate the color, shape and size of the label, each kind being given a different number, did not in themselves constitute good trade-marks, and that the manufacturer was not entitled to an injunction to restrain the use of the same numbers in the same way and for similar purpose by another, in connection with the latter's own name, either on the ground of infringement of a trade-mark or of unfair competition, there being no attempt to deceive in dress or style of package, and the labels themselves being such as were open to anyone to make.

In *Diamond Match Co. vs. Saginaw Match Co.*, 142 F. 727, the complainant manufactured tipped matches, and it was held that one who without a patent manufactured tipped matches in which it was essential that the head and the tip should be of different colors to enable users to distinguish the tip on which the match should be struck, was not entitled to maintain a monopoly in the use of any two particular colors merely because he used them first, and that their use by another manufacturer without any simulation of packages calculated to deceive purchasers as to the origin of the goods, did not constitute unfair competition.

The Court said:

"The primary colors, even adding black and white, are but few. If two of these colors can be appropriated for one brand of tipped matches, it will not take long to appropriate the rest. Thus, by appropriating the colors, the manufacture of tipped matches could be monopolized by a few vigilant concerns without any patent whatever."

In *R. J. Reynolds Tobacco Co. vs. Allen Bros. Tobacco Co.*, 151 F. 819, it was shown that the complainant and their predecessors in business from about 1880 had made and sold a brand of plug tobacco known as "Schnapps" and that in 1894 it had commenced placing upon the plugs tin tags having a dark background with the word "Schnapps" thereon in red letters slanting backward, which tag, as shown by the evidence, was novel and distinctive. During the following twelve years nearly 800,000,000 of such tags were used and also several million advertisements, hangers, etc., having thereon pictures of this tag which had become known throughout the Southern states as the distinctive mark of the Schnapps

brand. It was shown that many of the retail customers were unable to read and identified the complainant's tobacco entirely by the tag and the size and shape of the plug. Some years later the defendant placed upon the market a cheaper grade of tobacco in plugs of the same size and shape as those of the complainant, and with tags of the same size, shape, style and colors; the only difference being in the use of the name "Traveler" instead of "Schnapps," which difference could not be distinguished even at a short distance. The evidence showed that the simulation was intended to and did in fact deceive customers who desired to purchase the product of the complainant.

The Court held that such simulation constituted unfair competition and entitled the complainant to injunctive relief.

In *Saxlehner vs. Wagner*, 157 F. 745 and 216 U. S. 375, the complainant was the owner of a trade-name or trade-mark "Hunjadi Janos," for a natural bitter water, and it was held that in the absence of fraud or unfair competition it could not enjoin a manufacturer of an artificial bitter water from advertising and labeling his production as "Artificial Hunjadi," especially since the word "Hunjadi" had become a generic name for mineral waters of a certain type coming from a more less extensive district, if not from anywhere in Hungary.

In *Prest-O-Lite Mfg. Co. vs. Avery Lighting Co.*, 161 F. 648, the complainant manufactured and sold for use on automobiles patented tanks containing acetylene gas. When the gas was exhausted it exchanged a filled tank for the empty one, which it repaired, repacked if necessary, and refilled. Each tank bore a metal plate on which was engraved the complainant's trade-mark "Prest-O-Lite," the number and a patent notice. The defendant was a business competitor and made and sold tanks and gas under a different name. It bought and exchanged the empty tanks of the complainant and refilled and resold the same without removing the plate, although in some cases it covered a part of the plate by a paper label, easily removable, stating that the tank had been refilled by it. The court held that such acts infringed the trade-mark of the complainant, and also that there was unfair competition, which entitled the complainant to injunctive relief.

The Court said:

"The complainant is entitled to a preliminary injunction restraining the defendant from selling or passing off to its customers or the trade any of these 'Prest-O-Lite' gas tanks, filled with

acetylene gas, unless it removes therefrom the metal engraved plate or completely erases the words and figures thereon, and places on the same a plainly printed label stating that it does not contain gas and acetone made by the Prest-O-Lite Co."

In *Dixie Cotton Felt Mattress Co. et al vs. Stearns & Foster Co.*, 185 F. 431, the complainant was a manufacturer of mattresses of different grades, which it advertised and sold extensively under certain trade-names. The defendant made and sold mattresses of inferior material, marked with the same names as used by the complainant, and sold these mattresses to a large store which previously had handled the mattresses of the complainant. The defendant also furnished for display in store windows sample mattresses of the same quality as those of the complainant, which sample mattresses were exposed cut open to show the material. The court held that the purpose was clearly to deceive purchasers into buying such goods for those of the complainant, and that the complainant was entitled to an injunction.

In *L. E. Waterman Co. vs. Modern Pen Co.*, 197 F. 534, the complainant, L. E. Waterman Co., had established and built up a business in the sale of fountain pens under the name "Waterman's Ideal," when Arhtur A. Waterman left its employ and entered into a partnership under the name "A. A. Waterman & Co.," for the manufacture and sale of pens in competition with the complainant. Afterwards this latter company transferred its business, good-will, and the right to the name "A. A. Waterman & Co." to the defendant. It was clearly shown by the evidence that the use of the partnership name on the defendant's pens created confusion. In deciding this case the court held that to avoid this confusion and the deception of customers, the defendant would be enjoined from using the name "Waterman" at all unless it substituted for its firm name on its pens the name, "Arthur A. Waterman & Co.," and followed it by the words "Not connected with the L. E. Waterman Co."

The Court said:

"The record clearly demonstrates the confusion arising from the use by the defendant of the name 'A. A. Waterman & Co.' in the pen business, in view of its similarity to the name of the complainant. The defendant has the right to use the name, but the complainant and the public have the right to insist that provision be made for minimizing the confusion arising from such a use so far as practicable."

See also *Keystone Type Foundry vs. Portland Publishing Co.*, 180 F. 301; *Siegert vs. Gandolfi*, 149 F. 100; *American Wine Co. vs. Kohlman*, 158 F. 830; *Coats vs. Merrick Thread Co.*, 149 U.S. 502; *Bates Numbering Machine Co. vs. Bates Mfg. Co.*, 178 F.

681; McGraw Tire & Rubber Co. *vs.* Griffith, 198 F. 566; Wolf Bros. *vs.* Hamilton-Brown Shoe Co., 165 F. 413; reversed in 192 F. 930; Pope Automatic Merchandising Co. *vs.* McCrum-Howell Co., 191 F. 979; Strause *vs.* Weil, 191 F. 527; L. E. Waterman Co. *vs.* Modern Pen Co., 193 F. 242; Postal Telegraph-Cable Co. *vs.* Livermore & Knight Co., 188 F. 696; Howard Dustless Duster Co. *vs.* Carleton, 187 F. 472; and Mississippi Wire Glass Co. *vs.* Continuous Glass Pressing Co., 81 A. 374; Anheuser-Busch Brewing Ass'n *vs.* Piza, 24 F. 149; Nokes *vs.* Mueller, 72 Ill. App. 431; N.Y. Cab Co. *vs.* Mooney, 15 W. U. Cases 152.

## IV.

**Simulation of Merchandise and Dress of Goods**

Equity will not permit one manufacturer to dress his merchandise in imitation and simulation of the merchandise of a competitor whether such imitation be by the use of cartons, wrappers, labels, bottles, etc., simulating those used by another or by imitating the non-essential, artistic features of the merchandise itself.

In *American Chicle Co. vs. W. J. White Chicle Co., et al*, 196 F. 977, it was held that the defendant had intentionally imitated the packages, dress and advertisements of chewing gum made and sold by the complainant to such an extent as to constitute unfair competition and to entitle the complainant to an injunction.

The Court said:

"Upon the discs of the complainant's cards are printed the words 'Chew White's Yucatan Gum' while upon the defendant's gum are the words 'Use White's Meadow Mints to Chew,' the words 'Yucatan' and 'Meadow Mints' being in larger type than the other words, while around the discs at the margins of the cards of both are printed various catch phrases. The cards are of many colors, those of the complainant being of red, white and blue, while those of the defendant company are of red, yellow and green, and are manifestly a simulation of complainant's." The Court, although denying a preliminary injunction restraining the defendant company from using the word 'White' in connection with the sale of its chewing gum, said "but I think it (defendant) should not be permitted to use the pink wrapper and pink band or label binding together the pieces of gum, and should not be permitted to use the square advertising cards which apparently simulate the complainant's, for such are calculated to induce buyers of chewing gum to believe that the product of the defendant company is the product of the complainant."

In *Yale & Towne Mfg. Co. vs. Alder*, 154 F. 37, it was held that a manufacturer of locks who deliberately and intentionally copied a higher priced lock made by another manufacturer in form, size, color, lettering and details of finish so that the two were substantially identical in appearance to a casual observer, and retail purchasers were likely to mistake one for the other,

was chargeable with unfair competition, although the parts of the lock separately might have been open to his appropriation.

The Court said:

"Many of the features of the plaintiff's padlock were separately a fair subject of appropriation by rival manufacturers because they were not original with the plaintiff, but the plaintiff was the first to assemble them together in the concrete form in which its padlock has become known to the public as its product; and while we cannot say that the appropriation by the defendant of this particular feature or that particular feature would have been unfair, we can say that when all the prominent ones have been appropriated and so assembled together with slight variations in some of them, together they would produce the same general effect and the ordinary purchaser would not be apt to discover the difference. Enough appears to establish unfair competition."

In *George Frost Co. vs. E. B. Estes & Sons*, 156 F. 677, the complainant manufactured a hose supporter having a rubber button for attachment to the hose which was protected by a patent and which it advertised and sold under the trade-name of "Velvet Grip." The defendant made and sold wooden buttons intended for the same use colored in imitation of rubber and used on hose supporters which were sold by dealers as rubber buttoned supporters and sometimes as "Velvet Grip" supporters.

The Court held that such sales constituted unfair competition and that the defendant was chargeable as a contributor thereto and would be enjoined.

In *Rushmore vs. Saxon*, 158 F. 499, Aff. 170 F. 1021, the complainant was a manufacturer of searchlight lamps for automobiles, known generally by his name as "Rushmore" lamps. He also designed a new and distinctive ornamental shell to distinguish his lamps from those of other makers, such peculiar design being non-functional. The defendant, who was also a maker of lamps, and a competitor of the complainant, copied the latter's shell in all particulars, even to defects, although as shown by the evidence, the shape of the defendant's shell rendered his own lamps less effective for use. As a result, there was nothing to distinguish his lamps in appearance from those of the complainant, except the reading matter on a small and inconspicuous name-plate, which was also needlessly put on the same place on the shell as the plate of the complainant. The defendant furthermore sold and billed his lamps to purchasers as "Rushmore" lamps. His lamps, however, were of inferior material and of cheaper construction, and could be and were sold at a less price than those of the complainant. The court held that the defendant was chargeable with unfair competition, and that the



complainant was entitled to an injunction to restrain the same, the imitation being clearly by design, and for the purpose of misleading purchasers, to the injury of the complainant and to the advantage of the defendant.

In *Cook & Bernheimer Co. vs. Ross et al*, 73 F. 203, complainant bottled whiskey and sold the same under labels bearing the distiller's guarantee of purity. The bottles used by the complainant were of an original and peculiar shape and, by means of extensive advertising, such bottles came to be generally relied upon by purchasers as a means of identifying the whiskey bottled by the complainant. Some time after the adoption by the complainant of his peculiarly shaped bottles, the defendant, who had been dealing for a number of years in the same whiskey which was bottled by themselves, began to use a bottle of precisely similar shape and appearance to that used by the complainant, although bearing labels which were in no sense imitations of those used by the complainant.

The Court held that the use of such bottles by the defendant constituted unfair competition and should be restrained.

In *Sterling Remedy Co. vs. Spermine Medical Co.*, 112 F. 1000, the Court said:

"We have spoken so frequently on the subject of unfair competition in trade and have declared the principles which, as we conceive, govern such cases, that the case before us calls for no special consideration on the facts. There was here a manifest attempt to put upon the public the goods of the defendant as those of the complainant. The latter had provided a peculiar form for its tablets and a box of peculiar shape. This form and shape had not before been used in connection with such medicine. It is clear that the defendant adopted the style and shape of the boxes, the color of the tablet and the letterpress upon the boxes and in advertising, to palm off his goods as those of the complainant. It is not a case of accidental imitation in one respect; it is a case of deliberate and designed imitation in all respects. The facts bring the case under the ban of the law and the complainant was entitled to relief as well as against the form of the tablet and shape of the boxes as against the word 'Castorets.'"

In *Bates Mfg. Co. vs. Bates Machine Co.*, 141 F. 213, the Court said:

"But the complainant is clearly entitled to the relief sought on the second ground mentioned in its prayer for relief, namely, that the defendant be enjoined from imitating the labels on the complainant's boxes. The complainant's hand-numbering machines have long been put up in small rectangular boxes, upon the outer surfaces of which are pasted labels setting forth matters supposed to be of interest to the purchasers of the machine. On one end of each of these boxes is a label with the title 'A few Dont's.' The first two words "A Few" are in small capital letters; the last word 'Dont's' is in large capital letters. Under this title are seven sentences, each sentence with the word 'Don't' in heavy type.

The first sentence is 'Don't use rubber stamp ink upon pad of this machine.' The defendant's machines are likewise packed in small rectangular boxes, upon the outer surfaces of which are pasted labels containing matters supposed to be of value to purchasers. On one end of the defendant's boxes is a label at the top of which is the title 'A Few Don'ts.' The words 'A Few' are in small capital letters, and the word 'Don'ts' in large capital letters. Under the title are seven sentences, each commencing with the word 'Don't' in heavy type. Four of these seven sentences are literally the same as those used upon the complainant's boxes. The other three are substantially the same. . . . Other striking similarities between the labels upon the boxes of the complainant and the defendant might be pointed out. I am satisfied that the defendant should not be permitted to use these labels in marketing its machines as 'Model No. 49.' They are calculated to induce the purchasing public to believe that the defendant's machine, known as 'Model No. 49,' is a product of the complainant company." An injunction was granted.

In *Gorham Mfg. Co. vs. Weintraub*, 196 F. 957, the Court said:

"It is proven that the defendants, with the intention of diverting to themselves a portion of the good-will of complainant's business, have put upon the market and sold a silver-plated ware of inferior grade, but of the same general appearance as that of the complainant's solid or sterling ware, and to accomplish their purpose have used the complainant's insignia or trade-mark to cause it to be believed that their goods were of the same quality as complainant's. . . . That the defendants intended to engage in competition with complainant and by unfair and dishonest means to divert to themselves a part of its business is undeniable; actual confusion from the similarity of marking sufficiently appearing by the testimony of witnesses. . . . The complainant is entitled to a decree as prayed for in the bill, with costs."

See also *Charles E. Hires Co. vs. Consumers Co.*, 100 F. 809; *Ohio Baking Co. vs. National Biscuit Co.*, 127 F. 116; *Baglin vs. Cusenier Co.*, 156 F. 1019, modified in 164 F. 225; *McIlhenny vs. Hathaway*, 195 F. 652; *William Wrigley, Jr. Co. vs. L. P. Larson, Jr.*, Co. 195 F. 568; *Crystaleid Water Co. vs. Schultz*, 135 N.Y. Supp. 273; *Wirtz vs. Eagle Bottling Co.*, 24 A. 658; *Monopol Tobacco Works vs. Gensior*, 66 N.Y. Supp. 155.

*Putnam Nail Co. vs. Bennett*, 43 F. 800; *E. B. Estes & Son vs. George Frost Co.*, 176 F. 338; *B. Moore & Co. vs. Auwell*, 172 F. 508; aff. 178 F. 543; *Holeproof Hosiery Co. vs. Fitts*, 167 F. 378; *National Water Co. vs. Hertz*, 177 F. 607; *Lovell-McConnell Mfg. Co. vs. American Ever-Ready Co.*, 195 F. 931; and *Westcott Chuck Co. vs. Oneida Nat. Chuck Co.*, 199 N.Y. 247, reversing 118 N.Y. Supp. 1149.

## V.

### **The Acquisition of Secondary Meanings to Trade-Marks and Trade-Names**

The right to the use as a trade-mark or trade-name of a word or words descriptive or geographical in character may be acquired through long and continued use, provided that this use has been sufficient to impart to such word or words a secondary meaning whereby the proprietor or manufacturer and the origin

of the goods have become specifically designated, and are so known to the trade and public.

In *Elgin Watch Company vs. Illinois Watch Case Co.*, 179 U. S. 665, Chief Justice Fuller said:

"In other words the manufacturer of particular goods is entitled to the reputation they have acquired, and the public is entitled to the means of distinguishing between those, and other goods; and protection is accorded against unfair dealing, whether there be a technical trade-mark or not. The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another. If a plaintiff has the absolute right to the use of a particular word or words as a trade-mark, then, if an infringement is shown, the wrongful or fraudulent intent is presumed, and although allowed to be rebutted in the exemption of damages, the further violation of the right of property will, nevertheless, be restrained. But where an alleged trade-mark is not in itself a good trade-mark, yet the use of the word has come to denote the particular manufacturer or vendor, relief against unfair competition or perfidious dealing will be awarded by requiring the use of the word by another to be confined to its primary sense by such limitations as will prevent misapprehension on the question of origin. In the latter class of cases such circumstances must be made out as will show wrongful intent in fact, or justify that inference from the inevitable consequences of the act complained of."

In *Reddaway vs. Benham* (Appeal Cases, 19—1896), the plaintiff manufactured machine belting, which was sold in association with the trade-marks or trade-names "Camel" or "Camel Hair." The yarn of the plaintiff's belting consisted chiefly of camel hair, and while this yarn was commonly called "Camel Hair," it was not generally known that it consisted of the hair of the camel. The defendant manufactured a belting which it called "Camel-Hair Belting." Upon the findings of the jury the Court entered judgment for the plaintiff. On appeal this judgment was reversed and judgment entered for the defendant, as the Court in its opinion stated, that the words "Camel-Hair Belting" were descriptive of the article sold and the defendants were entitled to use these words in connection with the belting which they sold. On further appeal, however, to the House of Lords, the decision of the Court of Appeals was reversed and Lord Hershell, in stating his opinion, said:

"In the present case the jury have found, and in my opinion there was ample evidence to justify it, that the words 'Camel Hair' had in the trade acquired a secondary significance in connection with belting; that they did not convey to persons dealing in belting the idea that it was made of camel's hair, but that it was belting manufactured by the plaintiffs. They have found that the effect of using the words in the manner in which they were used by the defendants would be to lead purchasers to believe that they were obtaining goods manufactured by the plaintiffs, and thus both to deceive them and to injure the plaintiff. On authority as well as on principle, I think the plaintiffs are on these facts entitled to relief."

In *C. A. Briggs Co. vs. National Wafer Co.*, 102 Northwestern Rep. 87, plaintiffs employed in connection with the sale of their wafers the words "Boston Wafers" as a trade-name. Defendant questioned the right of the plaintiff to appropriate the words "Boston Wafers" as a trade-name, on the ground that they were both geographical and descriptive in character. The Court said:

"But it is also true that a merely descriptive epithet or the name of a person or of a place may become so associated with a particular kind of goods, or with the specific product of a particular manufacturer, that the mere attaching of that word to a similar product without more would have all the effect of a falsehood; and in such a case while the use of that word can not be absolutely prohibited, it may be restrained unless accompanied with sufficient explanations or precautions to prevent confusion with the goods of the original manufacturer or vendor."

In *Rushmore vs. Saxson*, 158 F. 499, Aff. 170 F. 1021, the Court said:

"Coming to the other branch of the case, the alleged unlawful appropriation of the name 'Flare Front,' we find more difficulty. That name, in no grammatical sense, is descriptive. But a descriptive name, or a name which to some extent is descriptive, if this be such, may come to have a secondary meaning, one which when heard or seen indicates to the trade, and to purchasers of a certain article, the goods or manufacture of a certain maker; those of the one using the name, and no other. It then becomes the trade-name of that particular manufacturer using it to designate his goods, and as such it is entitled to protection, provided he solely and arbitrarily selected and appropriated it."

In the case of *Standard Varnish Works vs. Fisher, Thorsen & Co.*, 153 F. 928, the Court said:

"The preparation in question is very naturally called 'Turpentine Shellac,' as it consists principally of a mixing or combination of the two more simple ingredients, turpentine and shellac, and, of course, in its ordinary signification the name is merely descriptive of the compound. It can scarcely indicate origin or proprietorship, so that it is not a term or designation suitable for appropriation as a trade-mark in the technical sense. As a trade-name, it may be properly so employed, but within itself it is inapt for exclusive appropriation as a trade-mark. Beyond this, however, words or symbols naturally descriptive of the product, while not adapted for exclusive use as a trade-mark, may yet acquire, by long and general usage in connection with the preparation and by association with the name of the manufacturer, a secondary meaning or signification, such as will express or betoken the goods of that manufacturer only, and in this sense will be entitled to protection from an unfair use of the designation or trade-name by others that may result in his injury or in fraud of the public."

In *Julius Kayser & Co. vs. Italian Silk Underwear Co.*, App. Div. (N.Y.), First Dept., decided February 13, 1914, the Court said:

"It seems to me that the plaintiff has clearly established, as against the defendant, an exclusive right to the word 'Italian' in connection with the silk underwear manufactured by it, and that the defendant's appropriation and use of the word in 1911, after plaintiff had made it valuable by long years of use, by registration

in the Patent Office, and by building up a large and successful business, was a violation of plaintiff's rights."

See also *Hansen vs. Siegel-Cooper Co.*, 106 F. 691; *Dr. A. Reed Cushion Shoe Co. vs. Frew*, 158 F. 552; *World's Dispensary Medical Association vs. Pierce*, 138 App. Div. 401 (N.Y.); *David E. Foutz Co. vs. S. A. Foutz Stock Food Co.*, 163 F. 408; *Elbs vs. Rochester Egg Carrier Co.*, 134 N.Y. Supp. 979; and *Globe-Wernicke Co. vs. Brown*, 121 F. 185; *Lawrence Mfg. Co. vs. Tennessee Mfg. Co.*, 138 U.S. 550; *Siegert vs. Gandolpi*, 149 F. 100; *Standard Varnish Works vs. Fisher, Thorsen & Co.*, 153 F. 928; *Heller & Merz Co. vs. Shaver et al*, 102 F. 882; *Lowe Bros. vs. Toledo Varnish Co.*, 168 F. 627; *Rome Machine & Foundry Co. vs. Davis Foundry & Machine Co.*, 68 S.E. 800; *Holeproof Hosiery Co. vs. Wallach Bros.* 172 F. 859 (97 C.C.A. 263). (Also 190 F. 608; *Modified* 192 F. 534); *Perkins vs. Apollo Bros.*, 197 F. 476; *Computing Scale Co. vs. Standard Computing Scale Co.*, 118 F. 965; *British-American Tobacco Co. vs. British-American Cigar Stores Co.* 211 F. 933.

## VI.

### Substitution

A manufacturer or dealer cannot substitute the merchandise of one where the merchandise of another is ordered, without informing the purchaser of that fact.

In *Samuel Brothers & Co. vs. Hostetter & Co.*, 118 F. 258, it was held sufficient to support a finding that the defendant was engaged in unfair competition, although there was no proof of any customer having actually been deceived, on the testimony of two witnesses employed by the complainant. These witnesses testified that they had gone to the wholesale liquor store of the defendant, where there had been sold to them by a clerk what was represented to them to be complainant's bitters, but which, in fact, was a spurious article made to imitate that of complainant's in appearance, taste and smell, and that they were also furnished by the clerk with empty bottles having thereon complainant's label and trademark to be used in retailing the bitters to customers.

In *Parkland Hills Blue Lick Water Co. vs. Hawkins*, 26 S. W. 387, the Court said:

"In the case under consideration the name adopted by the appellees and their predecessors for the water from the Blue Lick Springs indicated the origin and ownership of the place of the product and is one in the exclusive use of which the appellees should be protected. The proof discloses a scheme by which when the thirsty patron of certain dealers in the City of Louisville called for Blue Lick Water, meaning genuine Blue Lick Water, which was confessedly the Nicholas County product, he was to be given water from the artesian well of the appellant. This was no less a fraud on the public than on the appellees, as the purchaser has the right to get whatever he seeks and the owner is entitled to the profit from the sale of the thing sought."



In *Fisher et al vs. Blank*, 138 N.Y. 244, it was held that as defendant's tea had been handed out and sold when plaintiff's "Black Package Tea" was asked for, and that purchasers of and dealers in defendant's tea were from the same class as those who purchased and dealt in tea placed upon the market by plaintiff, that defendant was guilty of unfair competition.

In *Enoch Morgan's Sons Co. vs. Wendover, et al*, 43 F. 420, the Court held that the act of the salesman in offering "Pride of the Kitchen" in response to a demand for "Sapolio" was, though done silently, a positively unlawful act. Its unlawfulness consisted in an attempt to steal away the business of the complainant for the benefit of the manufacturers of "Pride of the Kitchen," and that it was clearly the object of the law of trade-marks to prevent acts of this character.

In *N. K. Fairbanks Co. vs. Dunn*, 126 F. 227, the Court said:

"The defendant, John F. Dunn, is conducting and transacting the business of a grocer at Little Falls, Rome, and Utica, in the state of New York. In his said business he had advertised Gold Dust, and has advertised to sell the same at a less price than the same can be obtained and sold for at a profit in the market. Having so advertised Gold Dust, the defendant has on several occasions knowingly and willfully and fraudulently handed out and delivered to his customers who called for Gold Dust, and who desired to purchase Gold Dust, and who expected they were purchasing and obtaining Gold Dust, another and inferior article known as Buffalo, and in so doing has not only imposed upon and defrauded purchasers to their damage and injury, but has injured the complainant. . . .

"The acts complained of are unlawful. The defendant has no right to deliver Buffalo when the customer calls for Gold Dust. The customer has the right to receive Gold Dust when he calls for it, and the seller purports to fill his order without taking pains to examine the package delivered, and he is defrauded if an inferior article is substituted, even if the package bears a label showing it to be Buffalo, and not Gold Dust.

"The customer at a grocery is not compelled to inspect every package called for to see that he gets what he orders. He has the right to assume that he gets what he orders. The merchant, by assuming to fill the order, represents that the goods put up and delivered are those ordered. The law is too well settled on this subject to require extended quotation. The manufacturer of an article placed upon the market for sale has the right to demand of the dealer who purports and advertises to sell it that he deliver his product when called for by the customer.

"The injunction pendente lite is granted, and will issue."

See also *The Searchlight Gas Company vs. Prest-O-Lite Co.*, Seventh Circuit, April 14th, 1914; *Horlicks Malted Milk Co. vs. A. Spiegel Co., et al*, 144 Northwestern Rep. 272; *Vitascope Co. vs. U. S. Phonograph Co.*, 83 F. 30; *Newcomer & Lewis vs. Scriven Co.*, 168 F. 621; *Parozone Co., Ltd., vs. Johnson Gibson*, 1904, 21 R.P.C. 317; *Prest-O-Lite Co. vs. Avery Lighting Co.*, 161 F. 618; *Holeproof Hosiery Co. vs. Wallach Bros.*, 172 F. 859; *Vehicle Apron & Hood Co. vs. Am. Tire & Rubber Co.*, 193 F. 372; *Rathbone Sard & Co. vs. Champion Steel Range Co.*, 189 F. 26; *Prest-O-Lite Co. vs. Auto Acetylene Light Co.*, 191 F. 90.

## VII.

**Corporate Names**

It is well settled that one corporation cannot adopt and use the name of another corporation in the same line of business. Furthermore a corporation cannot use as part of its corporate title the trade-mark or trade-name of another earlier in the field, nor can anyone use as a trade-mark for the same line of business the title or part thereof of a corporation or firm.

In *Rubber & Celluloid Harness & Trimming Company vs. The Rubberbound Brush Co.*, 88 A. 210, it was held that the use of the words "Rubber Bound" in defendant's corporate name was in contravention of plaintiff's rights in the term "Rubber Set" as applied to its merchandise.

In *Martell vs. St. Francis Hotel Co.*, 98 P. 1116, it was held that the defendant would be enjoined from conducting its hotel under the same name as that of plaintiffs, in the same neighborhood, and previously established, such use resulting in confusion and injury to the hotels and the public; and this, though defendant's hotel was larger and more expensive, and catered more to a transient trade, while that of plaintiffs, though patronizing transients, was more of a family hotel.

In *Mt. Hope Cemetery Asso. vs. New Mt. Hope Cemetery Asso.*, 92 N.E. 912, complainant owned the "Mount Hope Cemetery" since 1856. Shortly before suit was brought the defendant opened an adjoining cemetery under the name "New Mount Hope Cemetery" and advertised that its lands were connected with the drives of the complainant, inviting the public to enter its grounds in that way. Held, that the names were so similar as to be liable to cause confusion, and that the defendant should be enjoined from the use of the name "New Mount Hope Cemetery."

In *Rosenburg vs. Fremont Undertaking Co.*, 114 P. 886, it was held that a corporation could be enjoined from conducting a business under a name so similar to the name of a previously established corporation, association or partnership, engaged in the same line of business that confusion or injury would result therefrom.

In *Dyment vs. Lewis*, 123 N.W. 244, the plaintiff conducted his business under the name "Sioux City Robe & Tanning Co.," and built up a lucrative busi-

ness under this trade-name. Held, that equity would restrain another from engaging in the same business, at the same place, under the same name.

In *Kimball vs. Hall*, 89 A. 166, plaintiff advertised his business of cutting and welding metals by the oxy-acetylene, or oxy-carbide process, using the phrase "send it to Oxy," and became generally known in the trade and to his customers as "Oxy." Defendant put over a like shop on the same street, a sign "OXY Acetylene Welding & Cutting." Held, that such acts constitute unfair competition, and the fact that the plaintiff's business fell off while defendant's sign was up, and recovered when the sign was taken down, was *prima facie* evidence of damage.

*British-American Tobacco Co., Ltd., vs. British-American Cigar Stores Co.*, 211 F. 933. In this case complainant for eleven years had been extensively engaged in the wholesale tobacco business throughout the world, and had established an enviable reputation, dealing under the name "British-American." Though authorized to sell at retail, it had not done so, in order to conserve its wholesale trade. Defendant, a New Jersey corporation without any connection with complainant, organized itself to establish a chain of cigar stores under the name "British-American Cigar Stores Company." Defendant had no business in England nor anywhere else to warrant the use of the name "British," and during the years succeeding defendant's organization its use of the name "British-American" had caused confusion, and was calculated to lead the public to believe that there was some connection, financial or otherwise, between the companies, and induced the public to buy defendant's goods and its stocks and bonds, believing that they were issued by a corporation organized or connected with complainant. Held, that defendant's adoption of the words "British-American," which had become irrevocably associated with the tobacco business, of the Plaintiff was unlawful and would be enjoined.

See also *Northwestern Knitting Co. vs. Garon*, 128 N.E. 288; *Finney's Orchestra vs. Finney's Famous Orchestra*, 126 N.W. 198; *Williams Soap Co. vs. J. B. Williams Soap Co.*, 193 F. 384; *Wright Restaurant Co. vs. Seattle Restaurant Co.*, 122 Pac. Rep. 348; *Selchow et al vs. Chaffee & Selchow Mfg. Co.*, 132 F. 996; *Met. Tel. & Tel. Co. vs. Met. Tel. & Tel. Co.*, 141 N.Y.S. 598; *Dunstan vs. Los Angeles Van & Storage Co.*, 131 Pac. Rep. 115; *Lockport Canning Co. vs. Rosario Pusateri*, 79 Misc. 293; *Eastern Outfitting Co. vs. Manheim*, 110 P. 23; *Kansas Milling Co. vs. Kansas Flour Mills Co.*, 133 Pac. Rep. 542.

# VIII

## Accountings and Damages

In cases of trade-mark infringement and unfair competition, where the plaintiff prevails and the Court believes that the latter is entitled to a substantial recovery, damages will be awarded and an accounting as to the defendant's profits ordered.

In *Sawyer vs. Kellogg* (9 Fed. 601), the Court said:

"This is a motion to strike from the decree entered in the above case the clauses which direct an accounting and the payment of costs. . . . *As to the accounting*, The counsel for the defendant rests his application to strike out on two grounds: First, Because the proofs show that the defendant is not the person liable to account to the complainant. The evidence is that the defendant was largely engaged in packing blues on his own account and for others in the trade; that all the blues covered by the infringing trade-mark were put up by him for the firm of James S. Barron & Co., dealers in wooden ware, rope, and cordage in New York, who placed the same upon the market; that he made no sales to anyone of the articles thus packed; but received pay from his employers solely for the work and labor of packing. The bill of complainant prays for an injunction, and for profits and damages. Having been adjudged an infringer of the trade-mark of the complainant, an injunction has been issued against him. Under the above state of facts, should he be compelled to account for profits and damages? We have no doubt about the propriety of the reference, or of the liability of the defendant, if it can be shown on the accounting that profits were made by his work and labor, or that damages resulted to the complainant therefrom. If he did not sell, the profits on the sales are not chargeable to him; but if any profits came to him for preparing the article for those who did sell, they belong to the complainant, and the object of the accounting is to ascertain that fact, and, if the defendant has damaged the complainant by the unlawful use of his trade-mark, the nature and extent of the damage is a proper subject of inquiry."

In *The Collins Co. vs. Oliver Ames & Sons Corporation*, 18 Fed. Rep. 561, the Court said:

"The plaintiff is entitled to a decree for a perpetual injunction (against the use of plaintiff's trade-mark) as prayed in the bill, and for an accounting before a master as to profits and damages, and for the costs of the suit."

In *Atlantic Milling Co. vs. Rowland et al*, 27 Fed. Rep. 24, the Court said:

"The final decree establishes the right of the orator to the use of the word 'Champion' as a trade-mark for flour; that the defendants have infringed upon that right; and that the orator is entitled to recover of them the profits to the defendants, and damages to the orator, due to the infringement. . . .

"It is argued that the evidence does not show that the orator would have made this profit if the defendants had not. This might be true, and not affect the rights of the parties. If the defendants made profits by their invasion of the orator's rights, the orator is entitled to them whether the same profits would have been made by the orator or not, and not to any more if they would, for the same profits could not be made by both. But the master seems to have inferred that they would, and therefore to have found that the orator was damaged by the loss of profits to the same extent that the defendants saved by them. The fact that the flour of the orators bearing this mark was in the same market would seem to be sufficient to warrant this finding." *Faber vs. Hovey*, 1 Wkly. Dig. 529; S. C. 73 N.Y. 592.

In *Williams vs. Mitchell*, 106 Fed. Rep. 168, the Court said:

"The complainants also assert error in that the decree denied them compensation for past unfair competition. In this respect, also, we think the court was in error. The decree declares that the defendants, by their imitation of the complainants' advertisements, had been guilty of deceiving purchasers and the public into believing that the game boards of their make were the game boards made by the complainants. It declares an invasion of the complainants' rights, and the complainants are entitled, upon proper proof, to compensation to the extent of the invasion."

In *Florence Mfg. Co. vs. Dowd et al*, 189 Fed. Rep. 44, the Court said:

"This is not a case where this court or the Circuit Court can say in advance that the complainant will be unable to establish the amount of the gains and profits which the defendants have made by reason of the unfair methods employed by them in dressing up their brushes to resemble the complainant's brushes. Except in those cases where the court is convinced that such proof is impossible, an accounting should be ordered. It is true that the action for unfair competition is based upon fraud, but this may be inferred from the circumstances. As was said by this court in the case of *Fairbank vs. Windsor* 124 Fed. 200, 61 C.C.A. 233:

"In many of these unfair competition cases the fraudulent intent is inferred from the facts, sometimes against the sworn protestations of the infringer, that he was trying to differentiate his package from those of the complainant, not to simulate them.

"That the complainant's task seems difficult and the result an inadequate return for time and labor expended is not now important. The complainant is entitled to its hearing before the master; if it fails in its proof the Circuit Court will deal with the situation as to costs and expenses when it enters the final decree."

In *Westcott Chuck Company vs. Oneida National Chuck Company*, 199 N.Y. 247, modifying 118 N.Y.S. 1149, reversing 113 App. Div. 937, the Court said:

"We think, however, that the trial court erred in failing to award the plaintiff damages. The court doubtless felt controlled in this respect by the decision of the Appellate Division, made on an appeal from a previous trial of the case (122 App. Div. 260), in which it was held that in the absence of proof of damage no pecuniary recovery could be had. It is possible that in an action at law for damages, proof of actual damage suffered by a plaintiff would be necessary to justify more than a nominal recovery. (Brown on Trade-marks, No. 499; Paul on Trade-marks No. 324.) But this action is in equity. The plaintiff prayed as relief that the defendant account for the profits made on its sales, and the law seems well settled that equity will treat the wrongdoer as a trustee for the plaintiff so far as the former has realized profits from its acts. (Brown on Trade-marks, No. 506; Paul on Trade-marks, No. 326; see cases there cited. *Singer Mfg. Co. vs. June Mfg. Co.* supra.) It has been held in the United States Circuit Court of Appeals that a plaintiff is not limited to the profits realized by a defendant, but is entitled to what he would have made had the sales been made by him (*Walter Baker & Co. vs. Stack*, 130 F. 514).

See also *Atlantic Milling Co. vs. Robinson et al*, 20 F. 217; *Gillott vs. Esterbrook* 48 N.Y. 374; *Newman vs. Alvord* 51 N.Y. 189; *Hier vs. Abrahams* 82 N.Y. 519; *Walton vs. Crowley* 3 Blatchf. 440; *Frazie vs. Frazier Lubricating Co.* 18 Ills. Appeals 450; *Avery vs. Meikle* 85 Ky. 435; *Benkert vs. Feder* 34 F. 534; *Hennessy et al vs. Wilmerding-Loewe Co.* 103 F. 90; *American Tin Plate Co. vs. Licking Roller Mill Co.* 158 F. 690; *J. F. Rowley Co. vs. Rowley* 193 F. 390; *Wolf Bros. vs. Hamilton-Brown Shoe Co.* 206 F. 611.



## **Penal Laws**

Many states have, in addition to civil statutes regulating the registration of trade-marks, penal laws for the protection of the owners of trade-marks against infringement by unscrupulous competitors. In the limited space which we have here it would be impossible to give in detail the penal laws of the various states. For that reason we have only included in this work Sections 2353 and 2354 of the Penal Law of the State of New York, relative to the infringement of trade-marks. These sections read as follows:

### **Sec. 2353. Imitation of a Trade-Mark Defined**

An "imitation of a trade-mark" is that which so far resembles a genuine trade-mark as to be likely to induce the belief that it is genuine, whether by the use of words or letters, similar in appearance or in sound, or by any sign, device or other means whatsoever.

### **Sec. 2354. Offenses Against Trade-Marks**

A person who:

1. Falsely makes or counterfeits a trade-mark; or,
2. Affixes to any article of merchandise, a false or counterfeit trade-mark, knowing the same to be false or counterfeit, or the genuine trade-mark, or an imitation of the trade-mark of another without the latter's consent; or,
3. Knowingly sells, or keeps or offers for sale, an article of merchandise to which is affixed a false or counterfeit trade-mark, or the genuine trade-mark, or an imitation of the trade-mark of another, without the latter's consent; or,
4. Has in his possession a counterfeit trade-mark, knowing it to be counterfeit, or a die, plate, brand or other thing for the purpose of falsely making or counterfeiting a trade-mark; or
5. Makes or sells, or offers to sell or dispose of, or has in his possession with intent to sell or dispose of, an article of merchandise with such a trade-mark or label as to appear to indicate the quantity, quality, character, place of manufacture or production or persons manufacturing, packing, bottling, boxing or producing the article, but not indicating it truly; or,
6. Knowingly sells, offers or exposes for sale, any goods which are represented in any manner, by word or deed, to be the manufacture, packing, bottling, boxing or product of any person, firm or corporation, other than himself, unless such goods are contained in the original packages, box or bottle and under the labels, marks or names placed thereon by the manufacturer who is entitled to use such marks, names, brands or trade-marks; or,
7. Shall sell or shall expose for sale any goods in bulk, to which no label or trade-mark shall be attached, and shall by representation, name or mark written or printed thereon, represent that such goods are the production or manufacture of a person who is not the manufacturer,

Is guilty of a misdemeanor and punishable for the first offense by a fine not less than fifty dollars nor more than five hundred dollars or imprisonment for not more than one year, or both such fine and imprisonment, and for each subsequent offense by imprisonment for not less than thirty days or more than one year, or by both such imprisonment and a fine of not less than five hundred dollars or more than one thousand dollars.

See Prest-O-Lite Co. *vs.* Frederick Ray et al, 147 N. Y. Supp. 138; Peoples' Milk Co. *vs.* Doty, 118 N.Y.S. 966, 64 Misc. R. 595; Haslinghuis et al *vs.* Hencken, Haaren & Co., 143 N. Y. Supp. 1095; People *vs.* Streep, 128 N.Y.S. 172; People *vs.* Luhrs, 127 App. Div. 634, Aff. 195 N.Y. 377; People *vs.* Stricker, 102 N.E. 216; State *vs.* Bascowitz, 156 S.W. 945; People *vs.* Cannon, 139 N.Y. 32; Mullins *vs.* People, 24 N.Y. 399; People *vs.* New York Carbonic Acid Gas Co. 196 N.Y. 421; Ohio Oil Co. *vs.* Indiana, 56 App. Div. 143; Ricker *vs.* Leigh, 74 App. Div. 137; Howard *vs.* Moot, 64 N.Y. 262; Coleman *vs.* Shattuck, 62 N.Y. 348; People *vs.* Johnston, 185 N.Y. 229.

## CHAPTER VI

### The Trade-Mark Work of Munn & Company

**W**E began to practice as trade-mark and patent solicitors before the Civil War, and for seventy years we have been engaged continuously in this work.

During our two generations of service the law of trade-marks and unfair trade has grown from a thin trickle of judicial decision to a wide stream of statutes and precedents. We have kept track of the formation of this large body of law, and have assisted, in some measure, in shaping it.

Sixty-five years ago there were probably not more than a thousand trade-marks in existence in the United States. To-day, the registered trade-marks alone number above forty thousand.



THE CORTICELLI  
SILK TRADE-MARK. THE  
CAT'S HEAD IS PRINTED  
ON A LABEL PASTED ON  
THE END OF EVERY  
SPOOL.

Knowledge is only accumulated by experience, and we believe that we are justified by the facts in saying that we have had a larger and longer experience in Patent Office work than any other firm of patent solicitors.

We are entitled to practice before the Patent Office in cases concerning trade-marks as well as those relating to patents. Our work in this connection includes preliminary searches of the Patent Office files; registration of marks; and the conducting of opposition, interference and cancellation proceedings.

Our fees for trade-mark service are:

For registration of a trade-mark (if there is no opposition), \$15.00. To this fee should be added the government fee of \$10.00 for registration, making the total cost of registering a trade-mark, \$25.00.

If the mark includes a special design, an additional fee of \$5.00, to cover the expense of preparing the drawing, is charged.

For preparation of a design, or devising a trade-mark, where the idea is our own, we charge a fee based on the time and labor involved.

For search of the Patent Office files our charge is \$5.00. This search should always be made before an application for registration is filed.

After an application has been filed for registration, an examination is made by the Patent Office, for the purpose of ascertaining whether or not the application is anticipated. If the Trade-

Mark Examiner in the Patent Office refuses to register a trade-mark, an appeal may be taken to the Commissioner of Patents. If he reaffirms the Examiner's decision, another appeal may be taken to the Court of Appeals of the District of Columbia.

For conducting appeals our fee is based on the circumstances of the case.

It may happen that you have applied for registration of a trade-mark essentially similar to that of another registrant or applicant. In such a case the Commissioner of Patents is authorized to institute what are called "Interference Proceedings," for the purpose of ascertaining who is the rightful owner. If you are dissatisfied with the decision of the Examiner of Interferences, by whom the inquiry is conducted, you may appeal to the Commissioner in person; and from his decision you may appeal further to the Court of Appeals of the District of Columbia.

A registered trade-mark can be assigned only in connection with the good-will of a business in which the mark is used. The assignment must be recorded in the United States Patent Office within three months of its date, otherwise it is void as against any subsequent innocent purchaser for a valuable consideration. The Commissioner of Patents is required to keep a record of such assignments. The usual fee for preparing and recording an assignment is \$5.00.

Delays in registering trade-marks are often caused by the failure of trade-mark owners to supply us readily with all the information necessary to formulate an application for registration in proper form.

**Information  
Needed Be-  
fore an Ap-  
plication for  
Registration  
Can Be Pre-  
pared.**

If you are contemplating the registration of a mark, note carefully the following data which must be supplied.

1. Name of the owner of the trade-mark.
2. If the owner is a corporation, the State in which it has been incorporated; if a firm, the names of the members thereof.
3. Residence of the owner.
4. Place of business of the owner.
5. Nationality of the owner.
6. Whether the mark is used in interstate or foreign commerce, or commerce with the Indian tribes.
7. Class of merchandise on which the mark is to be used, and the particular description of the goods comprised in that class. Thus, the applicant must not state merely that a mark is to be used with "Shirts," but should be more specific, and state whether the shirts are outer or under garments, and of what material they are made.
8. A statement of the manner in which the trade-mark is applied to the goods. If by means of labels, six copies of the label should be furnished; if otherwise, six specimens of the mark as usually affixed.
9. As nearly as possible the earliest date on which the mark was used.

**SCIENTIFIC AMERICAN**

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AND GARDENS**

THE TITLES OF PERIODICALS SHOULD BE PROTECTED BY TRADE-MARK REGISTRATION.

10. Whether or not the mark is registered in any foreign country; and, if so, the date of registration or of the application for registration.
11. If the applicant be not a resident of the United States, the name and address of some person residing in the United States upon whom process may be served or notice of proceedings affecting ownership. (If desired, we can appear on the Patent Office records as the representative of a foreign registrant upon whom papers may be served.)

Many American manufacturers and exporters do not realize the importance of registering their trade-marks in the foreign countries to which their goods are sent. **Registration in Foreign Countries** Knowing only the trade-mark laws of the United States, where the title is derived from first use and is confirmed by registration, they often wait until it is too late before attempting to comply with the registration laws in other countries.

A fundamental difference between the trade-mark laws of the United States and those of Germany, Austria, Hungary, Argentine Republic, Bolivia, Brazil, Chili, China, Paraguay, Peru, Venezuela, Uruguay, Costa Rica, Guatemala, Denmark, Finland, Norway, Sweden, Spain, Japan and Cuba, is that in the foreign countries named the first to register a trade-mark acquires the property therein, to the exclusion of the rightful owner.

In many other countries the registration is, after a short period, also conclusive proof of ownership. American exporters will therefore see the importance of registering their marks in the foreign countries to which they send their goods.

We are prepared to register American marks in any country that has made provision for the registration of foreign-owned marks. Upon application, we will send a list of fees for registration in each country.

Our organization is complete in every particular. We have a highly trained staff of trade-mark specialists which **Our Facilities** we place at the service of our clients. Our branch office in Washington, located just across the street from the Patent Office, gives us unsurpassed facilities for rapid and accurate work. We are always in close touch with new trade-mark developments through being on the ground, and being engaged in daily practice before the Patent Office.

Under the present law those applications for the registration of trade-marks which have been passed and **Opposition Proceedings** allowed are published in the Official Gazette, and, within thirty days after the date of publication, any person who believes he would be damaged by the registration of a mark may oppose its registration by filing notice of opposition thereto. The opposer need not be the owner of a registered trade-mark, but, if registration is sought by another for a trade-mark so closely resembling one in use by the opposer on goods of the same descriptive properties as to be liable to cause confusion or mistake in the minds of the public or to deceive purchasers, the registration of such mark to the applicant would justify the opposer's belief that he would be damaged thereby.



Notices of opposition to be effective must be filed within thirty days after the date of publication of the mark sought to be registered in the Official Gazette.

Munn & Co. practice exclusively before the Patent Office, and therefore all litigation arising in the office of  
**Legal Causes** Munn & Co., such as suits for infringement of patents, trade-marks and copyrights, unfair business competition, the preparation of assignments, licenses and contracts, the formation of corporations, as well as validity and infringement opinions, are conducted by the law firm of Munn & Munn, Woolworth Building, 233 Broadway, New York.

## **MUNN & COMPANY**

**Solicitors of Patents**

WOOLWORTH BUILDING  
233 BROADWAY  
NEW YORK

625 F STREET  
WASHINGTON, D. C.

# Patents

We take this opportunity to call attention to the fact that our comprehensive practice includes not only the securing of the registration of trade-marks, but embraces as well the obtaining of Letters Patent in the United States, and all countries foreign thereto.

Numbered among our clients are some of the most successful inventors in the United States. Our endeavors are always directed to the securing of Letters Patent which will protect the inventions of our clients as broadly and adequately as possible. A copy of our Hand Book on Patents, in which this phase of our practice is fully discussed, will be mailed to any address, on application. We shall be pleased to give our unbiased, free opinion as to the probable patentability of any invention, provided a sketch and a description disclosing the same are sent to us. A distinct advantage possessed by our clients is found in the free notice which each patent taken out through our office receives in the "Scientific American."

## MUNN & CO.

**Solicitors of Patents and Trade-Marks**

**233 BROADWAY, NEW YORK  
and 625 F St., Washington, D. C.**

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